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No._____

Supreme Court, U.S.
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IN THE -

Supreme Court of the United States

October Term, 1986

IN RE ROBERT T. HOWITT.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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Questions Presented for Review

1. Whether the Court of Appeals for the Federal Circuit has jurisdiction to hear an appeal from a decision of the General Counsel of the Department of Commerce under the Equal Access to Justice Act, wherein the underlying decision occasioning the Petition for Fees relates to a patent application reviewed by the Board of Appeals?

2. Whether the Court of Appeals for the Federal Circuit erred by refusing to transfer a case to another court when the Court of Appeals found it had no jurisdiction over the case?

3. When a court construes its jurisdictional statute, should it tend toward a narrow construction which omits citizen access to the court or should it tend toward a broad construction which encourages citizen access to the court?

Parties to the Proceeding

Robert T. Howitt is the inventor whose patent is involved.

Frem Corporation is an assignee of the patent application.

United States Department of Commerce.

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Decision of Deputy Assistant Commissioner for Patents In re Application of Robert T. Howitt, Serial No. 728,129 Filed: September 30, 1976, For: TABLE, On Petition, Paper No. 32, dated June 16, 1983. It is unreported, but is reprinted in Appendix D hereto, p. 19a, *infra*.

Decision of Deputy Assistant Commissioner for Patents In re Application of Robert T. Howitt, Serial No. 728,129 Filed: September 30, 1976, For: TABLE, on Request for Reconsideration of the Decision of June 16, 1983, dated October 24, 1983. It is unreported, but is reprinted in Appendix C hereto, p. 15a, *infra*.

Decision of United States Department of Commerce Office of the General Counsel In re Application of Robert T. Howitt, Serial No. 728,129 Filed: September 30, 1976, For: TABLE, dated July 2, 1986. It is unreported, but is reprinted in Appendix B hereto, p. 3a, *infra*.

In re Robert T. Howitt, Appeal No. 86-1671 (Fed. Cir. February 18, 1987) which is unreported, but is reprinted in Appendix A hereto, p. 1a, *infra*.

IN THE

Supreme Court of the United States

October Term, 1986

No._____

IN RE ROBERT T. HOWITT.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Jurisdiction Statement

The judgement of the Court of Appeals for the Federal Circuit was entered on February 18, 1987. A timely petition for rehearing was denied on March 16, 1987. This Court's jurisdiction is appropriate under 28 U.S.C. §1254 (1).

Statutory Provisions Involved

5 U.S.C. §504(c)(2). Costs and Fees.

(c)(2) If a party other than the United States is dissatisfied with a determination of fees and other expenses made under subsection (a), that party may, within 30 days after the determination is made, appeal the determination to the court of the United States having jurisdiction to review the merits of the

underlying decision of the agency adversary adjudication. The court's determination on any appeal heard under this paragraph shall be based solely on the factual record made before the agency. The court may modify the determinations of fees and other expenses only if the court finds that the failure to make an award of fees and other expenses, or the calculation of the amount of the award, was unsupported by substantial evidence.

28 U.S.C. §1295(a)(4)(A). Jurisdiction of the United States Court of Appeals for the Federal Circuit.

(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction— . . .

(4) of an appeal from a decision of—

(A) the Board of Patent Appeals and Interferences of the Patent and Trademark Office with respect to patent applications and interferences, at the instance of an applicant for a patent or any party to a patent interference, and any such appeal shall waive the right of such applicant or party to proceed under section 145 or 146 of title 35.

28 U.S.C. §1631. Transfer to Cure Want of Jurisdiction.

Whenever a civil action is filed in a court as defined in section 610 of this title or an appeal, including a petition for review of administrative action, is noticed for or filed with such a court and that court finds that there is a want of jurisdiction, the court shall, if it is in the interest of justice, transfer such action or appeal to any other such court in which the action or appeal could have been brought at the time it was filed or noticed, and the action or appeal shall proceed as if it had been filed in or noticed for the court to which it is transferred on the date upon which it was actually filed in or noticed for the court from which it is transferred.

Statement of the Case

This case concerns the subject matter jurisdiction of the Court of Appeals for the Federal Circuit (CAFC). It arose with respect to an appeal of a petition for attorney fees filed pursuant to the Equal Access to Justice Act (EAJA), 5 U.S.C. §504. The petition had been submitted because of certain positions adopted and maintained by employees of the Commissioner of Patents and Trademarks of the United States Patent and Trademark Office (PTO) during the course of petitioner's prosecution of an application for a patent. On appeal from the General Counsel of the United States Department of Commerce, the CAFC, in an unpublished opinion, dismissed the appeal for lack of jurisdiction, and did not decide whether it would be in the interest of justice to transfer the case to another court.

The prosecutory history of the patent application is set forth as the essential background for understanding the petition now before this Court. On September 30, 1976, Robert T. Howitt, petitioner, filed a patent application, Serial No. 728,129, for an improvement in a table. The application was a continuation of a prior application, Serial No. 546,327, now abandoned, which itself was a division of another application, Serial No. 404,772, filed October 9, 1973 and which issued as U.S. Patent 3,875,873. During the course of the prosecution of the application, the Examiner noted that the "claims are not regarded as patentably distinguishing over the claims of applicant's prior U.S. Patent 3,875,873". *Ex parte Howitt*, Appeal No. 380-34, at 2. The application was for this reason said to involve the exact "same invention" as the applicant's own U.S. Patent 3,875,873, and was rejected under 35 U.S.C. §101 for "same invention" double patenting (and on other grounds not material to this dispute).

Title 35, U.S.C. §101 has been interpreted as providing that a party may obtain only one patent for an invention. *See, In re Vogel and Vogel,* 422 F. 2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970). This rejection is known as "same invention" type double patenting, a name used to distinguish it from a related but distinct rejection under 35 U.S.C. §103 for "obvious" variations in the scope of a claim with respect to an applicant's own prior issued patent. Such a rejection is termed "obviousness" double patenting. A rejection for "obvious" type double patenting may be overcome by adopting the termination date of the prior issued patent. In order to achieve such a resolution, an applicant files a "terminal disclaimer". "Same invention" double patenting, on the other hand, cannot be overcome by the submission of a terminal disclaimer.

The Examiner's rejection under 35 U.S.C. §101, was for "same invention" double patenting. He stated: "This is a 'same invention' type double patenting rejection and *cannot be overcome by a terminal disclaimer* (MPEP 804.02)". (Emphasis supplied). *Examiner's Answer Before the Board of Appeals, at 4.* The rejection having been made final, petitioner sought review before the Patent and Trademark Office Board of Appeals (now reconstituted as the Board of Patent Appeals and Interferences). The Board interpreted the "same invention" double patenting rejection as also including the related but distinct rejection for "obviousness" double patenting. The Board wrote that it had:

> . . . construed the foregoing stated rejection as holding (1) that the claims on appeal are for the "same invention", or identical subject matter, as that defined by the claims of the Howitt patent and are rejected under 35 U.S.C. 101 and (2) that the claims on appeal "are not regarded as patentably distinguishing over the claims of applicant's prior U.S. Patent 3,875,873," thus defining an obvious variation of the invention claimed in the Howitt patent and are therefore rejected as "double patenting".

The Board thereafter proceeded to overturn the rejection for "same invention" double patenting, but "affirmed" the "obviousness" double patenting rejection, a rejection which the Examiner had never issued. The decision was dated July 16, 1980.

On November 19, 1980, petitioner filed a terminal disclaimer pursuant to MPEP §804.02. However, on March 2, 1981, the Examiner held that the application had been abandoned. Thereafter, the petitioner filed a petition to withdraw the holding of abandonment, but it was denied on April 7, 1981 by the Director of the Examining Group. Two more petitions to the Group were filed seeking reconsideration of the holding of abandonment, with negative results. A fourth petition resulted in the Deputy Assistant Commissioner for Patents reversing the decision of the Group Director, thus withdrawing the holding of abandonment. The opinion, dated August 3, 1982, included the following statement: "The Board of Appeals decision inadvertently failed to state that the 'obvious' type double patenting rejection was a new ground of rejection under 37 C.F.R. 1.196 (b)." *Decision of Deputy Assistant Commissioner for Patents, at 1.*

Petitioner filed a petition for attorneys fees and also for the PTO to adopt regulations to award attorneys fees at a rate higher than the regulatory ceiling ($75/hr). The petition was based on the Equal Access to Justice Act, 5 U.S.C. §504. On June 16, 1983, a Deputy Assistant Commissioner ruled that the petition was defective for not showing the net worth of the applicant, and for insufficiently stating and documenting the claim for fees. Substantively, it was maintained that petitioner is an ineligible party because the Board proceeding would allegedly be subject to a trial de novo and is thus not an adjudication under 5 U.S.C. §504; and that the petition to revive the abandoned application is also not an adversary adjudication under 5 U.S.C. §504 because it supposedly is not required to be a hearing on the record.

As such, it was opined that the petitioner had not been involved in an adversary adjudication under the EAJA. Finally, it was ruled that the PTO positions were substantially justified.

Petitioner sought review of that decision before United States Department of Commerce, Office of the General Counsel and also by Petition for Reconsideration before the Commissioner of Patents. On October 24, 1983, another Deputy Assistant Commissioner for Patents ruled on the Request for Reconsideration, holding that the underlying matter involved was not an adversary adjudication, that it was not obligated to answer the original Petition within 30 days, and that Petitioner's initial Petition was not timely filed. The "trial de novo" reasoning was not repeated, and, therefore, apparently abandoned. Petitioner filed a Supplemental Appeal to the General Counsel and on July 2, 1986, it was ruled that the underlying matter was not an adversary adjudication. The question of the timeliness of the petition for fees was held to be moot. The holding of the Department, as well as the rulings of the Deputy Assistant Commissioner for Patents, is that Petitioner is an ineligible party under the EAJA.

Petitioner thereafter timely appealed to the Court of Appeals for the Federal Circuit. That Court dismissed the action on February 18, 1987 for lack of jurisdiction over the subject matter. A Petition for Rehearing was denied, and a Petition to Recall, Correct or Clarify the Court's Mandate and a Supplemental Petition to Recall Mandate were filed and were denied. This Petition for Writ of Certiorari timely followed.

Jurisdiction was believed to have been appropriate in the Court of Appeals for the Federal Circuit pursuant 28 U.S.C. §1295 (a)(4)(A). The jurisdictional issue only, however, is the subject of the Petition now before this Court.

REASONS FOR GRANTING THE WRIT

1. The decision below raises significant issues of federal law which have not been, but should be, settled by this Court.

The decision below raises significant, unresolved issues of Federal Law which this Court should resolve. The jurisdictional limit of the Court of Appeals for the Federal Circuit (CAFC) has been a matter of great controversy. *See, Wyden v. Commissioner of Patents and Trademarks,* 807 F.2d 934, 231 U.S.P.Q. 918 (Fed Cir. 1986). Petitioner's cause raises the issue of the CAFC's patent law jurisdiction in the context of an appeal from a government agency pursuant to the Equal Access to Justice Act (EAJA) 5 U.S.C. §504. The answer to the particular question raised by petitioner would impact upon all issues of jurisdiction in the nascent CAFC. Petitioner contends that a party may appeal a decision of the General Counsel of the Department of Commerce (DOC) denying an award of fees under the EAJA, where the opinion giving rise to the petition developed, in part, from a decision on a patent application appealed to the Board of Appeals.

The CAFC derives its subject matter jurisdiction from 28 U.S.C. §§1291, 1292, and 1295. The relevant provision herein is §1295(a)(4)(A) which provides for jurisdiction "... from a decision of ... the Board of Patent Appeals and Interferences of the Patent and Trademark Office with respect to patent applications ..., at the instance of an applicant for a patent." The decision below would seemingly constrict the CAFC's jurisdiction to traditional appeals under 35 U.S.C. §141 (which grants a right of appeal from Board decisions), and eschew authority over appeals more indirectly arising from

erroneous acts of the Board, especially where certain aspects of those decisions were, in the end, rectified by the Commissioner of Patents and Trademarks.

While it is undoubtedly true that the jurisdictional question in this case is principally one of statutory construction, a court ought to consider the realities and practicalities of its decisions. Congress, in considering the passage of the EAJA, viewed an almost Orwellian backdrop of endless bureaucratic maneuvering and evasion from responsibility. "While the influence of the bureaucracy over all aspects of life has increased, the ability of most citizens to contest any unreasonable exercise of authority has decreased. Thus, at the present time, the Government with its greater resources and expertise can in effect coerce compliance with its position." House Report No. 96-1418 in U.S. Code Cong. and Adm. News at 8635. The CAFC is the appellate court, below this Court which can best determine whether a decision of substantive patent law was correctly interpreted by the PTO, and pertinent hereto, whether the position of the PTO was "substantially justified". If the CAFC view is that it does not have jurisdiction over the matter, except upon appeal from the district court, it is adding an unnecessary layer of appellate review to what ought to be a simple procedure to obtain compensation when the bureaucracy acts unreasonably. There is no compelling need to develop a trial court record from what the PTO has fashioned. Its decision and other actions are set down in writing and are easily reviewed as is. In fact, the decision must be made on the administrative record; any trial would be totally wasteful. It would be far more practical to have the CAFC be the court which determines the reasonableness of PTO activity. This would simplify an already complex process and allow for the orderly disposition of such cases.

On the other hand, if the decision below indicates that the CAFC does not view the question of wrongful "abandonment" of a patent application by the PTO as involving a patent issue at all, there is a strong possibility that the most able court with respect to patent law would deny itself jurisdiction altogether (including appellate jurisdiction from District Courts), with the result that there would tend to be a split of authority about the reasonableness of PTO decisions. This would be in contradiction to the intent of Congress in creating the CAFC. Petitioner thus believes that this Court is presented squarely by the question raised with the issue of how and if the CAFC should hear cases, particularly cases arising from the Board of Appeals under the EAJA.

The decision below has the unfortunate effect of affirming without deciding, the adverse administrative opinion of the Department of Commerce which held PTO proceedings are not subject to the EAJA, for all practical purposes within the means of small companies and individuals. It thus places in jeopardy the ability of individuals or small businesses to challenge the type of governmental coercion which effectively ". . . undermines the integrity of the decision-making process." House Report No. 96-1418, in 1980 U.S. Code Cong. and Adm. News, at 8635. The issue is surely one of grave importance not only to practitioners before the CAFC and to individuals and small businesses who were supposed to be protected by EAJA, but to the fate of the EAJA. Other courts could similarly close the door to such cases by raising jurisdictional arguments about the appealability of EAJA proceedings arising from rectified underlying decisions. Such constrained interpretations could logically result in all EAJA appeals being considered moot.

The EAJA provides that a party dissatisfied with a determination of an agency concerning a petition for fees may appeal to a court which has jurisdiction over the decision which instigated the petition for fees.

> If a party other than the United States is dissatisfied with a determination of fees and other expenses made under subsection (a), that party may, within 30 days after the determination is made, appeal the determination to the court of the United States having jurisdiction to review the merits of the underlying decision of the agency adversary adjudication.

5 U.S.C. §504(c)(2). The CAFC has now turned this provision on its head, making its decision on the basis that one appeals to the Court having jurisdiction to review the petition, absent the above-cited statute. The CAFC's position could not conceivably be a correct interpretation of the law.

Moreover, the decision below can hardly be squared with *In re Haas*, 486 F.2d 1053, 1054, 179 U.S.P.Q. 623, 624 (C.C.P.A. 1973) which provides that the court ought to have "... an inherent power to review any action of the board which affects our appellate jurisdiction." Surely, the jurisdiction of the CAFC is affected where a patent application is rejected because the Examiner misconstrues an application, the Board misconstrues the Examiner, and the Examiner, and other agents of the Commissioner of Patents and Trademarks wrongfully carry into effect an erroneous Board decision by erroneously issuing a holding of abandonment. "The fact that a given Patent Office determination is not a decision under Section 141 does not mean that such determination is not reviewable in this court. Such determinations are reviewable here if they are logically related to a decision under Section 141, either on

patentability . . . or on priority." *In re James*, 432 F.2d 473, 476, 167 U.S.P.Q. 403, 406 (C.C.P.A. 1970) (concurring opinion of Judge Lane).

It is respectfully submitted that the CAFC is deeply divided with respect to all aspects of its jurisdiction. This division has become most apparent in the recent decision of *Wyden v. Commissioner of Patents and Trademarks*, 807 F.2d 934, 231 U.S.P.Q. 918 (Fed. Cir. 1986). In that decision, Chief Judge Markey wrote a blistering dissent, attacking the CAFC's assumption of jurisdiction in an appeal from a district court decision with respect to a patent agent's readmission to practice before the Patent and Trademark Office. The Chief Judge writes: "Not to put too fine a point on it, and again with all due respect, concern for the position of this court in the judicial system makes the assertion of jurisdiction in this appeal to me an embarrassment." 807 F.2d at 937, 231 U.S.P.Q. at 921. *See also, Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 227 U.S.P.Q. 977 (Fed. Cir. 1985); *Jaskiewicz v. Mossinghoff*, 802 F.2d 532, 231 U.S.P.Q. 477 (D.C. Cir. 1986). The jurisdictional issues involved in *Wyden* and the decisions below are closely intertwined, and, from a practical point of view, nearly identical. The question presented for review would provide the Court with an excellent vehicle through which to resolve the scope and limit of the CAFC's jurisdiction.

In support of the position that jurisdiction is appropriate in the CAFC, petitioner believes that the appeal provision for the EAJA, 5 U.S.C. §504(c)(2), requires a court to hear a case within the limits of the court's jurisdictional grant. Such limit would extend to any underlying action in the PTO which involves a decision from the Board of Appeals or which affects the CAFC's statutory grant of jurisdiction. *See generally, In re Haas, supra.* Alternatively, it is contended that the

Federal Circuit would have jurisdiction in aid of its jurisdiction, as it would pursuant to the All Writs Act, 28 U.S.C. §1651(a). *See, Margolis, Rushmore, Liu and Anderson v. Banner, Comr., Pats.*, 599 F.2d 435, 202 U.S.P.Q. 365 (C.C.P.A. 1979). After the Board's erroneous decision in the underlying matter, the Examiner, misinterpreting the Board's decision as affirming his rejection, erroneously abandoned the case. Such an abandonment was the equivalent of a rejection of a claim and would have been within the CAFC's "in aid of" jurisdiction, had the Commissioner not ultimately rectified the matter by withdrawing the holding of abandonment. *Accord, Margolis, supra.*

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 18, 148 U.S.P.Q. 459, 467 (1966), this Court indicated that the Patent Office was remiss for too easily issuing patents. "While we have focused attention on the appropriate standard to be applied by the courts, it must be remembered that the primary responsibility for sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system." The CAFC, in its role as the court hearing substantive patent law appeals from the PTO and from District Courts, has foregone an opportunity not only to protect the individual from the zealousness of bureaucrats, but also to protect the public from misapplication of the patent law by the PTO, a matter within its primary responsibility. This ought to be a simple process without need of endless appeal. It ought not require debilitating trial court litigation to render what amounts to an appellate decision.

This Court should for all of the above reasons grant the petition for writ of certiorari. It seems clear that significant, unresolved issues of broad interest are presented here which this Court ought to decide.

2. The decision below departed significantly from the accepted and usual course of judicial proceedings.

Petitioner also contends that the decision below is so significantly aberrant from the course of accepted and usual judicial proceedings that it would be appropriate that this Court grant certiorari. It is critical to this matter that any decision by the Court of Appeals for the Federal Circuit, especially a ruling with respect to its jurisdiction, has a magnified effect, because the CAFC is a court of nationwide jurisdiction, based on limited *subject matter*, rather than *geography*. *See*, 28 U.S.C. §§1291, 1292 and 1295. Aberrations by that court will not generally be subject to criticism or contrary opinions in other Circuit Courts of Appeal. As such, it bears an uniquely high risk of giving "effect to the will of the judge ...", *Wyden v. Commissioner of Patents and Trademarks*, 807 F.2d at 937, 231 U.S.P.Q. at 921 (Fed. Cir. 1986) (dissent of Markey, Chief Judge) quoting *Osborn v. Bank of the United States*, 22 U.S. (9 Wheat.) 738, 865 (1824), rather than to the will of Congress. "When a court acts beyond the jurisdiction granted it by Congress, a situation most grave is created." 807 F.2d at 943, 231 U.S.P.Q. at 925. Likewise, of course, when a court closes its doors to pleas of citizens granted access by Congress, a situation far more grave is created. Often, in the world of economic reality, jurisdiction denied is justice denied.

This case presents issues of absolute first impression, *see*, Dunner & Gholz, Court of Appeals for the Federal Circuit: Practice & Procedure §6.11 (1986), which would be of wide interest to the Patent Bar, if not generally to the Bar representing citizens and small businesses. The Court of Appeals for the Federal Circuit has dismissed the case for lack of jurisdiction in an opinion thoroughly

unreflective of the matter before it. It is conceded by Petitioner that a serious unresolved question is presented with respect to jurisdiction in the CAFC. The decision below, however, is totally unresponsive to the issue.

There are Five significant departures from accepted practice in the decision. Stated succinctly, they are: (1) a decision on a matter of first impression was not published and is not citable as precedent; (2) the decision was decided on an issue materially different from that briefed by either party, with no adequate opportunity provided to brief the issue that *was* decided; (3) the court failed even to address transferring jurisdiction as specifically prescribed by statute. 28 U.S.C. §1631; (4) the Court's decision thoroughly mischaracterizes the case before it; (5) the decision does not take seriously or even recognize the jurisdictional complexities created by 5 U.S.C. §504(c)(2).

Two of the issues described above as being aberrant require further elaboration. Firstly, it is stated that the decision below was apparently rendered on the basis of an unbriefed issue. It is true that the issue of the court's jurisdiction was argued on brief by attorneys for Petitioner and the Department of Commerce. However, neither party raised an argument that jurisdiction could or could not lie in the Federal Circuit, as opined in the decision below, because the matter is an appeal from the Department of Commerce. It was assumed (and logically so, by all involved) that the matter could be appealed to the court having jurisdiction to decide the underlying Patent (or Administrative law) decision, as specifically provided for by Congress. *See*, 5 U.S.C. §504(c)(2).

Secondly, it seems obvious that the decision below mischaracterizes the matter entirely. The issue as to jurisdiction is not whether a decision of the tribunal

deciding the Petition for Attorneys fees would be appealable to the Federal Circuit, but rather whether the actions of the underlying decision complained of in the Petition for Attorneys fees, to wit, activities within the PTO, would be properly appealed to the Federal Circuit. This is made clear beyond a shadow of a doubt in 5 U.S.C. 504(c)(2), which provides for review of an EAJA petition in: "the Court of the United States having jurisdiction to review the merits of the *underlying decision of the agency adversary adjudication.*" [Emphasis supplied].

The issue as to jurisdiction concerns, for purposes of the case, the character of the underlying decision and whether that underlying decision is appealable to the CAFC. If the Federal Circuit, because of the very unusual nature of its jurisdiction, believes that it cannot exercise jurisdiction in this matter because 28 U.S.C. §1295(a)(4)(A) only allows for review from the PTO in the nature of a patent appeal taken *immediately* from the Board of Patent Appeals and Interferences or by petition explicitly requesting a writ of mandamus under the All Writs Act, 28 U.S.C. §1651(a), "in aid of" its jurisdiction, *see, Margolis, Rushmore, Liu, and Anderson v. Banner, Com'r. Pats.*, 599 F.2d 435, 202 U.S.P.Q. 365 (C.C.P.A. 1979), it should say so clearly and publicly. This is not apparent from the jurisdictional statute. The Federal Circuit ought to indicate why it does not have jurisdiction over a matter when the statutes apparently clearly gives its jurisdiction over the matter, and when it is clear that Congress intended for the court to have jurisdiction over the matter. 5 U.S.C. §504(c)(2).

The terse grounds stated by the Court as justifying its position are patently ambiguous. The first ground is that the case is an appeal from the Department of Commerce

and, apparently, that the CAFC's jurisdictional statute does not explicitly allow the CAFC to hear any appeals from the Commerce Department. That position is clearly contradicted by 5 U.S.C. §504(c)(2) that directs appeals to the court having jurisdiction to review the underlying matter, which in this case could reasonably be argued to grant the CAFC jurisdiction to hear such appeals, based on the CAFC's general jurisdictional statute. The second ground is that, because the Board decision complained of in the Petition for Fees was eventually rectified by the Commissioner of Patents, no appeal would lie in the Federal Circuit, apparently, because the matter is moot. This position effectively repeals court review of administrative law cases under the EAJA. Under this theory, because the underlying decision was disposed of prior to its appeal to a Court, it is moot and can not serve as the basis for jurisdiction in the CAFC, despite 5 U.S.C. §504(c)(2). Therefore, it would seem to follow that disputes under the administrative portion of the EAJA (as opposed to the portion concerning government errors before courts) are not appealable by virtue of the underlying decision. This is a result clearly in contradiction to the statute and the will of Congress.

It could be protested that the Court below intended to characterize the underlying proceeding as being an administrative law action before the Commissioner which, generally speaking, would not be directly appealable to the CAFC. *But see, Margolis, supra;* 28 U.S.C. §1651(a). The language of the Court's opinion belies that interpretation. "Any errors stemming *from that decision* [The Board's decision] were rectified by the Commissioner's granting of Howitt's petition to withdraw the holding of abandonment of his application." *In re Robert T. Howitt,* Appeal No. 86-1671 at 2 (Fed. Cir. February 18, 1987) (emphasis supplied).

The only fair interpretation of this sentence, taken in context, is that the PTO corrected the error of the Board and thus no issue remained. Surely the consequent actions with respect to errors made by the Board are appealable to the Federal Circuit, *In re Haas, supra*, especially where those actions are properly characterized as *de facto* rejections, or as actions seemingly designed to frustrate the Federal Circuit's jurisdiction. *See*, 37 C.F.R. §1.197(a)[1]; *Margolis, supra*. In short, jurisdiction was not even considered on the basis of the All Writs Act, 28 U.S.C. §1651(a) although *Margolis* was cited in Petitioner's (Appellant's) Reply Brief. *Reply Brief for Appellant* at 4. It is urged that the underlying case, had it not been resolved, at the least, was properly reviewable under the All Writs Act[2] and the Federal Circuit could have taken jurisdiction by virtue of that act.

---

[1] 37 C.F.R. §1.197(a) as existing at the time relevant to this case, states: "After decision by the Board of Appeals, the case shall be returned to the primary Examiner, subject to the appellant's right of appeal or other review, for such further action by the appellant or by the primary Examiner, as the condition of the case may require, to carry into effect the decision."

[2] The condition of the case after the Board of Appeals decision, wherein the Board had not issued a rejection although it had stated new grounds for the rejection of the claims in the application, clearly required the primary Examiner "to carry into effect the decision" by issuing a rejection or setting a time period to respond to the Board's de facto rejection. Such action would have allowed petitioner to maintain its prior argument, to wit, that there was no issue, properly speaking, of double patenting, or it would have allowed petitioner to file a terminal disclaimer. The Examiner did not act and Petitioner filed a terminal disclaimer. Rather than accept the terminal disclaimer, the Examiner decided that the case had become abandoned. It thus seems reasonable to assert that the CCPA would very arguably have had jurisdiction had the matter not been, after several petitions, finally resolved by the case being revived. As such, it would be reasonable to assert jurisdiction in this EAJA case in the CAFC by virtue of the All Writs Act, 28 U.S.C. §1651(a).

It is suggested further that the Equal Access to Justice Act, 5 U.S.C. §504 is an act designed so that courts will take action in aid of their jurisdiction. As originally enacted, a stated purpose of the statute is as set forth in the EAJA, Pub.L. No. 96-481, §202(c)(1), 94 Stat. 2325, in pertinent part: (c) It is the purpose of this title—(1) *to diminish the deterent effect of seeking review of, or defending against, governmental action* . . ." [Emphasis supplied]. While it is arguable that the EAJA is merely a provision for monetary relief after the fact, it seems very possible that it is a statute "in aid of" court jurisdiction, intended to ensure the equitable administration of law by the various agencies. Whatever the merits of this argument, it is quite clear that the court ought, at least, have indicated that a serious problem with respect to its jurisdiction was raised and have asked counsel to brief the issue in detail. While a court, of course, is not *compelled* to so act, the novelty, importance and likely broad impact of a published opinion on jurisdiction and on the underlying issue of the applicability of the EAJA to Patent Office proceedings ought to have suggested its appropriateness.

Instead, the CAFC indicated, in ordering the non-publication of the case, that its opinion "does not add significantly to the body of law and is not of widespread legal interes.". *Opinion Below* at 1; *See*, Fed. Cir. R. 18. If the essence of the Court's opinion had been published prior to the present cause, this petitioner would certainly have handled this appeal differently. *Stare decisis* is an important doctrine in the orderly conduct of justice Secret decisions, such as this one, destroy that doctrine.

It is respectfully submitted that the CAFC acted in this case, seemingly according to its own perception of justice and without due recourse to established judicial procedure. In effect, that Court has, by secret opinion, quashed an appeal which raised issues of first impression and of great public importance without duly setting forth its reasoning for purposes of public scrutiny, and without (alternatively) considering the transfer of the case to a court which it perceives as having appropriate jurisdiction in the matter. This decision has the attributes of an "illegitimate exercise of raw judicial power", *Wyden, supra* at 937, 231 U.S.P.Q. at 921, and, in effect, affirms without discussion the self-serving position of the Patent and Trademark Office and the Department of Commerce that the Equal Access to Justice Act is not available to protect citizens or small businesses that apply for patents. This is surely an abuse of discretion of the first order and cries out for the Supreme Court to review the decision below.

3. The CAFC decision below violates the CAFC's own precedents as well as the precedents of other jurisdictions.

In *Zinger Construction Company, Inc. v. U.S.*, 753 F.2d 1053, 1055 (Fed. Cir. 1985), the CAFC wrote: "Pursuant to discretion vested in this court by 28 U.S.C. §1631 (1982), we should transfer the case to the United States Claims Court if we find that to do so would be in the 'interest of justice'." The exercise of this discretion clearly requires the court to determine whether a transfer would be in the interest of justice. Such a decision would appropriately be made by the court, assuming it finds that it lacks jurisdiction. *See also, Tatelbaum v. U.S.*, 749 F.2d 729 (Fed. Cir. 1984). The CAFC, in the decision below, has failed to follow its own precedent, because it did not make a finding whether it would be in the interest of justice to transfer jurisdiction.

With the exception of the present case, it seems to be a universally accepted rule of law that, where a court finds that it lacks jurisdiction, the court will decide whether it would be in the interest of justice to transfer the case to another jurisdiction. 28 U.S.C. §1631; *Hempstead County & Nevada County Project v. U.S. Environmental Protection Agency*, 700 F.2d 459 (8 Cir. 1983); *In re Exclusive Industries Corp.*, 751 F.2d 806 (5 Cir. 1985); *In re Carter*, 759 F.2d 763 (9 Cir. 1985). Whatever ambiguity may exist in the statute has been eliminated by the clear and consistent practice of courts. A court which dismisses a case for lack of jurisdiction must determine whether it would be in the interest of justice to transfer jurisdiction. If the determination is affirmative, then the court must transfer the case to the proper jurisdiction. To act otherwise is to violate precedent, to celebrate form over substance and, even more ominously, to disobey the clearly expressed will of Congress.

Conclusion

For the reasons set forth above, it is urged that the granting of this petition for writ of certiorari would be appropriate. The issue is of likely broad public interest and directly affects the public well-being. The case provides an excellent backdrop for reviewing issues concerning the CAFC's grant of jurisdiction.

Respectfully submitted,

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APPENDIX A

Decision—Appeal No. 86-1671
(Fed. Cir. February 18, 1987)

Note: This opinion will not be published in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

UNITED STATES COURT OF APPEALS

For the Federal Circuit

Appeal No. 86-1671

IN RE ROBERT T. HOWITT.

DECIDED: February 18, 1987

Before MARKEY, *Chief Judge*, RICH and NIES, *Circuit Judges*.

NIES, *Circuit Judge*.

DECISION

Robert T. Howitt seeks review of the decision of the General Counsel for the Department of Commerce, denying him attorney fees under the Equal Access to Justice Act (EAJA), 5 U.S.C. §504. We *dismiss* for lack of jurisdiction.

Appendix A—Decision—Appeal No. 86-1671
(Fed. Cir. February 18, 1987).

DISCUSSION

As provided in 28 U.S.C. §1291, this court's jurisdiction is limited to that described in 28 U.S.C. §§1292(c), 1292(d), and 1295. Howitt's appeal, taken from a decision by the General Counsel for the Department of Commerce, does not fall within our jurisdictional bounds.

Howitt argues that the Federal Circuit is vested with jurisdiction because it has jurisdiction to review the decisions of the board and examiner that underlie this case. That argument is misguided in that the board's decision is not before us in this appeal. Any errors stemming from that decision were rectified by the Commissioner's granting of Howitt's petition to withdraw the holding of abandonment of his application. Here Howitt seeks to overturn the Commerce Department's denial of attorney fees, a decision which this court has been given no jurisdiction to review.

APPENDIX B

Decision of United States Department of Commerce, Office of the General Counsel

Received
Jul -9 1986
Blodgett & Blodgett, P.C.

UNITED STATES DEPARTMENT OF COMMERCE
OFFICE OF THE GENERAL COUNSEL
Washington, D.C. 20230

Petition for Attorney Fees and Expenses Under the Equal Access to Justice Act

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In re Application of Robert T. Howitt
Serial No. 728,129
Filed: September 30, 1976

For: TABLE

DECISION

This matter concerns the review of an initial decision made by the Patent and Trademark Office (PTO) denying an application for attorney fees under the Equal Access to Justice Act (EAJA) (5 U.S.C. §504). The underlying matter concerned a patent application which had been finally rejected by the PTO, the claimant's appeal to the PTO Board of Appeals, which partially overruled the patent examiner, and a subsequent notice of abandonment by the PTO, which the claimant was

successful in having withdrawn. After consideration of the claimant's Petition for Review and Supplemental Appeal, I deny the application on the ground that the underlying proceedings are not covered by section 554 of title 5 of the U.S. Code and, therefore, are not adversary adjudications for purposes of the EAJA.

BACKGROUND

This matter arose out of patent application, Serial No. 728,129, for a snack table filed September 30, 1976, by Robert T. Howitt. The application was related as a continuation to an earlier-filed application, Serial No. 546,327, now abandoned, which itself was a division of yet another application, Serial No. 404,772, filed October 9, 1973, now patent No. 3,875,873. On February 13, 1978, the patent examiner finally rejected claims 13-16 of the application on the ground that they constituted double patenting:

> These claims are not regarded as patentably distinguishing over the claims of applicant's prior U.S. Patent 3,875,873. This is a "same invention" type double patenting rejection and cannot be overcome by a terminal disclaimer (MPEP 804.02).

On May 2, 1978, the claimant unsuccessfully sought a reconsideration by the patent examiner of the final rejection. The claimant then appealed to the Board of Appeals on June 8, 1978.

In a decision mailed July 16, 1980, the Board construed the rejection of the examiner as holding:

> (1) that the claims on appeal are for the "same invention," or identical subject matter, as that defined by the claims of the Howitt patent and are

> rejected under 35 U.S.C. 101 and (2) that the claims on appeal "are not regarded as patentably distinguishing over the claims of applicant's prior U.S. Patent 3,875,873," thus defining an obvious variation of the invention claimed in the Howitt patent and are therefore rejected as "double patenting." *In re Vogel*, 57 CCPA 920, 422 F.2d 438, 164 USPQ 619 (1970).

The Board found that the rejection of claims 13-16, on the ground of "same invention" type of double patenting, was not supported. Nonetheless, the Board did find that the rejection should be sustained on the ground of double patenting of the "obviousness" type, because claims 13-16 defined "an obvious variation of the patent claims." A rejection based upon the "obviousness" type of double patenting may be overcome by the filing of a terminal disclaimer."

In response to the decision of the Board of Appeals, the claimant filed a terminal disclaimer on November 19, 1980, to overcome the "obvious variation" basis for rejection of the claims. Notwithstanding, on March 2, 1981, the PTO notified the claimant that the application was considered abandoned in view of the Board's decision. In response, claimant petitioned for withdrawal of the notice of abandonment. The petition to withdraw was denied by the PTO on April 7, 1981. Two requests for reconsideration were made by the claimant further seeking the withdrawal of the notice of abandonment. Both were denied by the Director of Group 350. Finally, the claimant petitioned the Commissioner of the PTO under 37 C.F.R. 1.181 to reverse the decision that the application was abandoned.

Appendix B—Decision of United States Department of Commerce, Office of the General Counsel.

On August 3, 1982, the Deputy Assistant Commissioner for Patents withdrew the holding of abandonment. The Deputy Assistant Commissioner's decision was based upon the failure of the Board to denote the "obvious variation" basis for rejecting the claims of the claimant as a "new ground of rejection under 37 C.F.R. 1.196(b)" and for failing to set a period for response to the new ground of rejection. Thus, the claimant had six months from the Board's July 16 decision in which to respond, and had timely done so when the terminal disclaimer was filed in November 1980. The claimant subsequently filed a request for attorney fees and expenses under the EAJA.

On June 16, 1983, a decision under the EAJA was issued by PTO finding that the matter involved was not an "adversary adjudication" within the meaning of the EAJA, and alternatively that the position of the Government was substantially justified. On July 14, 1983, a petition for review was filed with this office, concurrent with a Request for Reconsideration filed with the PTO. The request for reconsideration under the EAJA was denied by the PTO. Thereafter, on November 22, 1983, a Supplemental Appeal to the General Counsel was filed.

DISCUSSION

The EAJA provides for an award of attorney fees and expenses to a prevailing party involved in an adversary adjudication with a Government agency, unless the position of the agency in the proceeding was substantially justified, or special circumstances make the awarding of fees and expenses unjust. *See* 5 U.S.C.

§504(a)(1). A clear threshold requirement, which must be met before a claimant is eligible for an award of fees and expenses, is that the proceeding must be an "adversary adjudication."[1] This term is defined within the EAJA as:

> an adjudication under section 554 of this title [5 U.S.C. §554] in which the position of the United States is represented by counsel or otherwise. . . .

5 U.S.C. §504 (b)(1)(c). Section 554 of title 5, U.S. Code, part of the Administrative Procedure Act (APA), provides:

> (a) This section applies, according to the provisions thereof, in every case of adjudication *required by statute to be determined on the record after opportunity for an agency hearing*. . . .

(Emphasis added).

The Department regulations implementing the EAJA do not indicate that the examination of a patent application in accordance with 35 U.S.C. §131, an appeal to the Board of Appeals under *id.* §134, and the consideration by the Commissioner of a petition for withdrawal of a notice of abandonment are covered proceedings.

See 15 C.F.R. §18.4(a)(4). However, §18.4(b) states:

> The Department's failure to designate a proceeding as an adversary adjudication shall not preclude the filing of an application by a party who believes the proceeding is covered by the Act; whether the proceeding is covered will then be an issue for resolution in proceedings on the application.

[1] The EAJA also establishes net worth eligibility requirements which the prevailing party must also satisfy. *See* 5 U.S.C. §504 (b)(1)(B). For purposes of this discussion, I assume *arguendo* that the claimant satisfies these requirements.

Hence, the issue to be resolved is whether the activities of the patent examiner, the Board of Appeals, or the Commissioner of the PTO are covered by the EAJA, meaning whether they are "required by statute to be determined on the record after opportunity for an agency hearing."[2] The claimant addresses this point in his Supplemental Appeal.

The claimant's basic contention is that it is unnecessary for the governing statute to explicitly state that a hearing is to be "on the record" for a proceeding to be covered by section 554. Further, it is argued that the action taken by an examiner is a "decision" and, thus, should be encompassed by section 554 as either an " 'agency process for formulation of an order' or as a 'final disposition.' " Supplemental Appeal p. 8. The claimant also contends that the proceedings before the Board of Appeals is covered by section 554, inasmuch as 35 U.S.C. §7 provides for a "hearing." Finally, the claimant maintains that the petition to the Commissioner regarding the withdrawal of the notice of abandonment is a hearing covered by section 554, as it concerns an "error of law," and "[t]o state that a review of a question of law is not an issue requiring a hearing is absurd." Supplemental Appeal p. 14. In effect, the position of the claimant seems to be that any time a "decision" is made by the Government a hearing is required. And every

[2] The EAJA also requires the Government's position to have been represented by counsel or otherwise. The Government was not represented by counsel, or otherwise, before the patent examiner or the Commissioner. The patent examiner did file an answer with the Board of Appeals in response to the appeal brief. But it is questionable whether the examiner's answer would constitute a representation of the position of the United States. However, I do not reach this issue since none of the proceedings are hearings "on the record" covered by section 554. *See* discussion pp. 8-12, *infra*.

time a hearing is provided, it must be in accordance with section 554, regardless of whether the governing statute provides for a hearing on the record, or even a hearing at all. Obviously, such an interpretation is an untenable position.

There are two types of adjudicative "hearings" which may be provided for under a statute: formal and informal. Which one is appropriate depends upon the language of the statute and its legislative history.

> A fundamental and well-recognized distinction exists between a requirement that an agency provide a "hearing" and a requirement that an agency provide a "hearing on the record." Formal proceedings do not attach to a requirement of a "hearing;" such proceedings would obtain only on the requirement of a "hearing on the record."

Railroad Commission of Texas v. United States, 765 F.2d 221, 227 (D.C. Cir. 1985), *citing United States v. Florida East Coast Railway Co.*, 410 U.S. 224, 234 (1973); *United States v. Allegheny-Ludlum Steel Corp.*, 406 U.S. 742, 757 (1972); *United States Lines, Inc. v. Federal Maritime Commission*, 584 F.2d 519, 536 (D.C. Cir. 1978). *See also Sea-Land Services, Inc. v. United States*, 683 F.2d 491, 495-6 (D.C. Cir. 1982); *City of West Chicago v. U.S. Nuclear Regulatory Commission*, 701 F.2d 632, 644 (7th Cir. 1983). Section 554 is applicable only when the hearing is formal, "on the record." When section 554 applies, sections 556 and 557 also apply making the proceeding a "trial type" hearing. *See* 2 K. Davis, Administrative Law Treatise, §10.7 (2d ed. 1982).

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The claimant correctly observes that the governing statute need not explicitly state that the hearing must be "on the record" before section 554 applies. However, a formal hearing is not due merely because the statute provides for some kind of hearing. Courts have recognized that the governing statute or its legislative history should indicate with clarity that a trial type proceeding is to be provided before the formal procedures of section 554 are imposed. *See United States Lines, Inc.*, 554 F.2d at 536; 2 K. Davis, *supra* §12.10 at p. 450. *See also City of West Chicago*, 701 F.2d at 645; *Sea-Land Services, Inc.*, 683 F.2d at 495.

The only applicable statute governing the processing of a patent application, which references any sort of a hearing, is 35 U.S.C. §7. This statute provides that the Board of Appeals should review adverse decisions of examiners upon applications for patents, which each appeal being "heard" by at least three members of the Board. For the claimant, this is enough to bring into play section 554.[3] However, that statute itself does not

[3] The claimant also relies upon *Seacoast Anti-Pollution League v. Costle*, 572 F.2d 872 (1st Cir. 1978); and *Marathon Oil v. Environmental Protection Agency*, 564 F.2d 1253 (9th Cir. 1977), to support his proposition that where the statutory scheme provides for appellate judicial review of an agency proceeding, the underlying agency action may be brought "within the matrix of 554(a)," pointing to the fact that 35 U.S.C. §141 provides for appeals of decisions of the Board of Appeals to the U.S. Court of Appeals for the Federal Circuit. In *Seacoast* the court stated:

> "We are willing to presume that, unless a statute otherwise specifies, an adjudicatory hearing subject to judicial review must be on the record. The legislative history of the APA and its treatment in the courts bear us out.

(Footnote continued on following page.)

provide that the hearing is to be "on the record" and the legislative history does not indicate that there is to be a trial type proceeding.

See S. Rpt. No. 1979, 82d Cong. 2d Sess., *reprinted in* 1952 U.S. Code Cong. & Adm. News pp. 2394, 2400. *See also* remarks of Representative Jenckes (Rhode Island) on H.R. 1714, which became R.S. §4892, Act of July 8, 1870, ch. 230, 16 Stat. 202, the predecessor of 35 U.S.C. Chapter 13, *Cong. Globe* 41st Cong., 2d Sess. p. 2682 (April 14, 1870). At best, a proceeding before the Board of Appeals is "quasi-adjudicative" in nature, which does not merit the formal, trial type hearing required by section 554. *City of West Chicago*, 701 F.2d at 645.

(Footnote continued from preceding page.)

572 F.2d at 877 (footnotes omitted). However, as observed by Kenneth Davis in his treatise on the APA, "Nothing the court cites in its footnotes supports either part of its second sentence."

The claimant's reliance upon *Seacoast* and *Marathon Oil* is misplaced. In both *Seacoast* and *Marathon Oil* the statute providing for judicial review of the agency action expressly stated that the agency determination was to be "on the record after notice and opportunity for hearing." *See* 33 U.S.C. §1369(c). However, there is no provision within 35 U.S.C. Chapter 13 which indicates that the underlying act of the Board of Appeals is to be "on the record." *Cf. City of West Chicago,* 701 F.2d at 644. *See also Steadman v. Securities and Exchange Commission*, 450 U.S. 91, 96 n. 13 (1981) (the proceeding at issue was "virtually identical" to another proceeding in the same act which was expressly to be "on the record," and the Commission was required to prove "virtually identical" violations of securities law); *Union of Concerned Scientists v. U.S. Nuclear Regulatory Commission*, 735 F.2d 1437, 1444 n. 12 (D.C. Cir. 1984) (examination of the statute's legislative history clearly indicated that Congress intended a formal hearing).

Consequently, there is no basis for concluding that the proceeding before the Board of Appeals is covered by section 554.[4]

Further, even assuming *arguendo* that the proceedings before the Board of Appeals are formal hearings under section 554, the actions of the patent examiner would still not be so covered. The claimant asserts that the findings of the patent examiner are covered by section 554, because they are "intermediate proceedings" and are either the "final disposition" or are "agency process for the formulation of an order" of PTO. However, merely because the determination by the patent examiner may have some practical consequences, it is not enough to cause the patent examination process to be covered by section 554, as part of any "agency process" in the formulation of an order.

In *ITT v. Electrical Workers*, 419 U.S. 600 (1975), relied upon by the claimant in his Supplemental Appeal, the Supreme Court addressed whether a proceeding under section 10(k) of the National Labor Relations Act (NLRA) was covered by section 554 of the APA, inasmuch as the proceeding under section 8(b)(4)(D) of the NLRA was so covered. The Court considered the

[4] Where Congress intends that a formal hearing be held pursuant to section 554 of the APA, it provides so with some clarity. Under 35 U.S.C. §32, which provides that the Commissioner of the PTO, after notice and hearing, may suspend or exclude any person from practice before the PTO, the statute expressly provides: "The reasons for any such suspension or exclusion *shall be duly recorded.*" While Congress did not use the precise phrase "on the record," this statute unquestionably indicates that a formal, trial type hearing, pursuant to section 554, is intended. *See also* 1052 O.G. 28, §10.144 (March 5, 1985). Any such indication is absent in the proceedings at issue here.

"practical consequences" a determination under section 10(k) would have on any subsequent section 8(b)(4)(D) proceedings, concluding:

> But we do not think that such practical consequences alone make the §10(k) proceeding related to the §8(b)(4)(D) proceeding in a manner that would make the former "agency process" for the formulation of the order in the latter.

Id., 419 U.S. at 445. This conclusion was reached because the section 10(k) proceeding had a "life of its own" apart from the actions taken under section 8(b)(4)(D). The section 10(k) determination was "not unlike an advisory opinion" and its " 'findings and conclusions are not *res judicata* on the unfair labor practice issue in the later §8(b)(4)(D) determination.' " *Id.*, 419 U.S. at 446, *quoting NLRB v. Plasters' Local Union No. 79*, 404 U.S. 116, 122 n. 10 (1971). Consequently, the section 10(k) proceeding did not have to be conducted pursuant to section 554 of the APA. *Id.*, 419 U.S. at 447-8.

Such is also the situation regarding the patent examination process with respect to the Board of Appeals. The actions taken by the patent examiner are very much separate and apart from the proceedings before the Board of Appeals. Moreover, the findings and conclusions of the patent examiner are hardly to be considered even an advisory opinion. These findings and conclusions clearly have no *res judicata* effect upon the Board. Hence, the patent application examination process is not "agency process" in the formulation of an order, let alone a "final decision." Therefore, even if it were assumed that a proceeding before the Board of Appeals was to be conducted in accordance with section 554, the actions taken by the patent examiner are not so covered.

Lastly, the consideration by the Commissioner of the PTO of the petition seeking the withdrawal of the notice of abandonment is not a "hearing" covered by section 554 *because* it concerns a question of law. The trial type hearing required by section 554 "is always inappropriate in non factual questions." 2 K. Davis, *supra* §12:10 at p. 448. *See also Sea-Land Services, Inc.*, 683 F.2d at 496. Therefore, the consideration by the Commissioner regarding a petition for the withdrawal of the notice of abandonment is not a proceeding covered by section 554. Because I conclude that the underlying proceedings are not adversary adjudications for purposes of the EAJA, a basic eligibility requirement, it is unnecessary to address the issue of whether the PTO was substantially justified, or whether special circumstances existed which would make an award of attorney fees and expenses unjust.[5]

WHEREUPON, having considered the Petition for Review and the Supplemental Appeal filed by the claimant in this matter and finding that the proceedings involved herein are not adversary adjudications for purposes of the EAJA, since they are not formal hearings conducted in accordance with section 554 of the APA, I DENY the petition as being filed by an ineligible party.

This is the final decision of the Department of Commerce in this matter. The claimant is hereby notified of the right under 15 C.F.R. §18.23 to seek judicial review of the Department's final decision.

Dated this 2 day of June (July DAR), 1986.

DOUGLAS A. RIGGS
Douglas A. Riggs

[5] There is also some question whether the petition for an award was timely filed. However, this issue is also mooted in view of the disposition of this matter.

APPENDIX C

Decision of Deputy Assistant Commissioner for Patents

For: TABLE, on Request for Reconsideration of the Decision of June 16, 1983

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

COPY MAILED	RECEIVED
OCT 24 1983	OCT 26 1983
DEPUTY ASST. COMM.	BLODGETT & BLODGETT, P.C.

In re Application of
Robert T. Howitt
Serial No. 728,129
Filed September 30, 1976
For: TABLE

Paper No. 34

ON PETITION

This is a decision on the petition filed July 15, 1983, for reconsideration of a decision rendered June 16, 1983, which denied a petition submitted September 8, 1982, for an award of attorney fees and other expenses sought pursuant to 5 U.S.C. 504 and 15 C.F.R. Part 18.

The fees and other expenses for which petitioner seeks an award are listed in Exhibit B of the petition submitted September 8, 1982. The fees and expenses listed include, among other charges, charges connected with:

Appendix C—Decision of Deputy Assistant Commissioner for Patents.

A. responding to Patent and Trademark Office (PTO) actions in the instant application and an earlier application;[1]

B. appealing the final rejection in the instant application to the Board of Appeals;[2]

C. petitioning from a holding of abandonment in the instant application.[3]

As noted above, petitioner is seeking an award pursuant to 5 U.S.C. 504[4] and 15 C.F.R. Part 18.[5] The Equal Access to Justice Act (EAJA) 5 U.S.C. 504, provides for

[1] The instant application was filed September 30, 1976, under 37 C.F.R. 1.60 as a continuation of application Serial No. 546,327. A number of charges listed in Exhibit B predate September 30, 1976.

[2] The examiner finally rejected all the outstanding claims on February 16, 1978, under 35 U.S.C. 101 on the ground of double patenting and under 35 U.S.C. 103 over some prior art. In a decision rendered July 16, 1980, the Board of Appeals did not sustain the rejection under 35 U.S.C. 103. The rejection under 35 U.S.C. 101 was affirmed to the extent the Board of Appeals held that the claims on appeal did not patentably distinguish over the claims in U. S. Patent No. 3,875,873.

[3] On November 19, 1980, applicant filed a terminal disclaimer. The application was held abandoned because, as stated in a decision on petition of April 7, 1981, the terminal disclaimer was filed late, outside the period of time permitted by 37 C.F.R. 1.197(c) to respond to a Board of Appeals decision. However, subsequently on August 3, 1982, the holding of abandonment was withdrawn by treating the July 16 Board of Appeals decision as containing a new ground of rejection with a six month period for response.

[4] Public Law 96-481, Title II, 203(a)(1), October 21, 1980, 94 Stat. 2325 known as the Equal Access to Justice Act, effective October 1, 1981.

[5] Part 18 was added to the C.F.R. in order to implement the Equal Access to Justice Act and is the same as the model rule (46 Fed. Reg. 32900, June 25, 1981) issued by the Chairman of the Administrative Conference of the United States (ACUS) except for minor changes made to accommodate the Department of Commerce's organizational structure.

the award of the attorney fees and other expenses to eligible individuals and entities who are parties to certain administrative proceedings called "adversary adjudications" before the Department of Commerce, including the PTO (15 C.F.R. 18.1). "Adversary adjudications" are those proceedings that are subject to 5 U.S.C. 554 (15 C.F.R. 18.2(a), 18.4(a)). *Fidelity Construction Co. v. United States*, 700 F.2d 1379, 1385 (CAFC 1983). Under Section 554, such proceedings are those proceedings required by statute to be determined on the record after opportunity for an agency hearing. In the PTO, only disbarrment proceedings of attorneys and agents under 35 U.S.C. 32 are considered to fall within the meaning of 5 U.S.C. 554 and hence, be classified as "adversary adjudications."

Petitioner has not pointed out how the fees and other expenses, for which an award is sought, stem from any "adversary adjudications" under 5 U.S.C. 554. Rather, the petition filed September 8, 1982, merely points to a decision rendered August 3, 1982, identifies that decision as an adversary adjudication, and requests an award for the charges set out in Exhibit B of the September 8 petition. However, the decision rendered August 3, 1982, does not constitute an adversary adjudication within the meaning of 5 U.S.C. 554.

There is no statute, regulation, or policy requiring that a question of whether or not a holding of abandonment of a patent application should be withdrawn be determined after an opportunity for hearing. By contrast, where Congress intended that the PTO afforded an opportunity for a hearing, it clearly expressed its intention for such a hearing, as in 35 U.S.C. 32. *Cogar v. Schuyler*, 464 F.2d 747, 751 (D.C. Cir. 1972).

Appendix C—Decision of Deputy Assistant Commissioner for Patents.

The instant petition for reconsideration centers around the argument that the Government had 30 days in which to answer a petition brought under the EAJA, and that the failure to answer within that time is the equivalent of a consent to the award requested. No such consent has taken place. The 30 day rule is inapplicable. The fees and other expenses, for which an award is sought, do not stem from proceedings of the type contemplated by the EAJA. They do not stem from an adjudication proceeding. Moreover, the regulation (15 C.F.R. 18.16) permits, but does not require the treatment of the failure to answer within 30 days as consent.[6]

There is a further reason why the petition filed on September 8, 1982, does not come within the scope of 5 U.S.C. 504 and, therefore, must be denied. It was submitted beyond the 30 days afforded by the statute. Section 18.14 requires that an application for an award be "filed no later than 30 days after the PTO's final disposition of the proceeding. Petitioner submits that August 3, 1982, is the date of such a final disposition. However, the date the petition was filed is September 8, 1982. This date is more than 30 days from August 3, 1982. Hence, the petition assuming it fits within the other requirements of the EAJA, was submitted too late. *Monarch Boat Co. v. NLRB*, 708 F.2d 1322 (8th Cir. 1983).

Reconsideration of the petition for an award under the EAJA and 15 C.F.R. Part 18 has been given. However, the petition stands denied.

JAMES E. DENNY
James E. Denny
Deputy Assistant Commissioner
for Patents

Norman S. Blodgett
43 Highland St.
Worchester, Mass. 01608

[6] 46 Fed. Reg. 32900, 32908 (1981).

APPENDIX D

Decision of Deputy Assistant Commissioner for Patents

For: TABLE, On Petition, dated June 16, 1983

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Copy Mailed
Jun 16 1983
Deputy Asst. Comm.

Received
Jun 18 ____
Blodgett & Blodgett, P.C.

AD/DLS/mr
Paper No. 32

In re Application of
Robert T. Howitt
Serial No. 728,129
Filed: September 30, 1976
For: TABLE

ON PETITION

This is a decision on a petition to the Commissioner requesting an award of fees and other expenses under 5 USC 504(a)(2) and 15 CFR 18 (Federal Register, March 31, 1982, page 13510).

STANDING

Petitioner alleges it "became the prevailing party in an adverary (sic) adjudication . . ." on August 3, 1982. Petitioner also alleges it is "a corporation having a new (sic) worth of less that $5,000,000, at the time that the adversary adjudication was initiated." Finally, petitioner alleges that the "position of the agency was not substantially justified."

Appendix D—Decision of Deputy Assistant Commissioner for Patents.

THE LAW AND IMPLEMENTING REGULATIONS

On October 21, 1980 Congress passed the "Equal Access to Justice Act", 5 USC 504, Pub. L. 96-481 (hereinafter called "the Act"), which in pertinent part provides;

§504. Costs and fees of parties

> (a)(1) An agency that conducts an adversary adjudication shall award, to a prevailing party other than the United States, fees and other expenses incurred by that party in connection with that proceeding, unless the adjudicative officer of the agency finds that the position of the agency as a party to the proceeding was substantially justified or that special circumstances make an award unjust.

Department of Commerce rules relating to the Act are published at 15 CFR, Part 18 (Federal Register, Vol. 47, No. 62, March 31, 1982, page 13510).

BACKGROUND OF THE PATENT APPLICATION

Application Serial No. 728,129 for a table was filed September 30, 1976 by Robert T. Howitt. It was related as a continuation to an earlier-filed application, Serial No. 546,327 now abandoned, which itself was a division of yet another application Serial No. 404,772 filed October 9, 1973, now patent No. 3,875,873.

During the prosecution of the application, the examiner

> rejected [the claims] under 35 USC 101 on the ground of double patenting. These claims are not regarded as patentably distinguishing over the claims of applicant's prior U.S. Patent 3,875,873. This is a "same invention" type double patenting rejection and cannot be overcome by a terminal disclaimer (MPEP 804.02).

Appendix D—Decision of Deputy Assistant Commissioner for Patents.

This rejection became the subject of an appeal to the Patent and Trademark Office Board of Appeals. The Board

> construed the foregoing stated rejection as holding (1) that the claims on appeal are for the "same invention", or identical subject matter, as that defined by the claims of the Howitt patent and are rejected under 35 USC 101 and (2) that the claims on appeal "are not regarded as patentably distinguishing over the claims of applicant's prior U. S. Patent 3,875,873," thus defining an obvious variation of the invention claimed in the Howitt patent and are therefore rejected as "double patenting". *In re* Vogel, 57 CCPA 920, 422 F. 2d 438, 164 USPQ 619 (1970).

Thus, in its decision, the Board found two rejections, the first based on the "same invention" and the second, "as defining an obvious variation of the applicant's earlier No. 3,875,873 patent claims." The Board reversed the first rejection and sustained the second, saying

> Since we agree with the examiner's position that the claims on appeal differ from the claims of appellant's patent in scope only, the rejection of the claims as "not . . . patentably distinguishing over the claims of applicant's prior U.S. Patent 3,875,873" will be sustained.

(Not at issue herein is the Board's reversal of the examiner's rejection of the same claims as unpatentable over certain prior art on the basis of 35 USC 103.)

The Board decision was dated July 16, 1980. On November 19, 1980, applicant filed a terminal disclaimer in accordance with the Manual of Patent Examining Procedure 804.02.

Appendix D—Decision of Deputy Assistant Commissioner for Patents.

Then, on March 2, 1981, the examiner notified the applicant that the application was abandoned in view of the Board decision which "affirmed" the examiner, which decision had not been appealed. Consequently, applicant filed a petition to withdraw the holding of abandonment which was denied by the Director of the Examining Group on April 7, 1981. Applicant sent two more petitions to the Group asking reconsideration of the refusal to withdraw the holding of abandonment, both receiving the same negative response. Finally, applicant asked the Commissioner to reverse the decision of the Group Director and withdraw the holding abandonment.

By decision of August 3, 1982, the Deputy Assistant Commissioner did just that, and returned the file to the Examining Group where the application file was prepared for issuance. The Notice of Allowance was mailed December 7, 1982. This petition was filed September 8, 1982.

REQUESTED RELIEF

Petitioner requests awarded of attorney fees under 15 CFR 18 and further requests that "the Department . . .adopt regulations providing that attorney fees may be awarded at a rate higher than the ceiling set forth in 18.7(b), citing "special circumstances," 15 CFR 18.8. Specifically, petitioner requests a rate ceiling of at least $124 per hour in cases involving a patent attorney or agent, especially this case. Petitioner attaches an itemized accounting of time spent by petitioner, a patent law firm, with two columns, one at the 15 CFR 18.7 ceiling of $75 per hour and on at the requested higher rate of $124 per hour.

Appendix D—Decision of Deputy Assistant Commissioner for Patents.

PROCEDURAL ISSUES

1. Eligibility

Petitioner has failed to establish eligibility under 15 CFR 18.5 (f) and 18.12. An applicant for an award under the rules must provide a "detailed exhibit showing the net worth of the applicant and any affiliates" . . .

2. Fee Documentation

The petition is defective under 15 CFR 18.13 in that it fails to specify the total amount claimed. Also to validate the items claimed, petitioner should have submitted vouchers, receipts or photocopies thereof.

SUBSTANTIVE ISSUES

To qualify for an award petitioners must meet two major conditions: it must have prevailed in an adversary adjudication and the position of the agency as a party to that adjudication must have been not substantially justified or special circumstances existed which would make the award unjust. In the absence of special circumstances, two questions must therefore be answered: were the Patent and Trademark Office proceedings in which petitioner prevailed adversary adjudications under the Act and, was the position of the Patent and Trademark Office in that proceeding substantially justified?

At item 9 of the petition, petitioner "contends that the Examiner's original basis of rejection was not substantially justified." Thus this Patent and Trademark Office proceeding was a rejection of the claims in a patent application under 35 USC 101. Applicant, after

those claims had been twice rejected, appealed the decision of the examiner to the Board of Appeals under 35 USC 134.

At item 10 of the petition petitioner "contends that the Notice of Abandonment and the subsequent denials of petitions were not substantially justified." The rejection and the abandonment process are separate and distinct proceedings. The first is an ex parte process under 35 USC 131; the second involves a failure to prosecute an application in the time fixed by 35 USC 133.

In order to determine upon which, if any, of the Patent and Trademark Office proceedings petitioner is entitled to grant of an award, we must first establish what is an adversary adjudication under the law and the rules. 15 CFR 18.4 specifies the proceedings covered. The Department wide proceedings are civil rights hearing and handicap discrimination hearings. The Patent and Trademark Office proceedings are identified at 18.4(a)(4) as disbarment proceedings of attorneys and agents under 35 USC 32. That list is not exclusive; Section 18.4(b) provides that coverage will be an issue if alleged. To determine coverage then, we must go to the Act itself. 5 USC 504(b)(1)(C) states "adversary adjudication means an adjudication under section 554 of this title in which the position of the United States is represented by counsel or otherwise, . . ." Section 554(a)(1) of Title 5 states "This section applies, according to the provisions thereof, in every case of adjudication required by statute to be determined on the record after opportunity for the agency hearing, except to the extent there is involved a matter subject to a subsequent trial of the law and the facts de novo in a court."

Appendix D—Decision of Deputy Assistant Commissioner for Patents.

The decision of the examiner, or the decision of the Board of Appeals to the extent that it differs therefrom, is appealable under 35 USC 145 to the United States District Court for the District of Columbia, and this appeal is a trial de novo; see Blood v. Brenner, 158 USPQ 540 (D.C., Dist. Col.), and McNeely v. Brenner, 172 USPQ 540 (D.C., Dist. Col.). It is clear then that 5 USC 504(b)(1)(C) precludes granting an award on a proceeding contesting the examiner's original basis of rejection.

(The remaining condition, that an award will be granted unless it is found that the position if the Patent and Trademark Office was substantially justified, will be discussed even though the discussion of adversary adjudication is dispositive. A rejection of a claim based on 35 USC 101 is a fundamental issue in any patent application; it rests on the proposition that the statute does not provide for the category of invention as susceptible of protection. Perpetual motion machines are non-statutory, as are methods of doing business and naturally occurring articles. Until a recent Supreme Court decision, micro-organisms were thought to be non-statutory. Diamond v. Chakrabarty, 206 USPQ 193 (Supreme Court, 1980) enlarged the body of law with respect to 35 USC 101. Determinations of non-statutory subject matter are the cornerstone of proprietory interests in technological innovation. Those determinations must be made in an environment free from potential second-guessing. In the absence of any evidence showing unreasonable action, the "Examiners original basis of rejection" on 35 USC 101 must be seen as substantially justified under the Act.)

It remains to determine the nature of the proceeding in which the Notice of Abandonment was issued and the petitions to withdraw that holding were denied. A determination of abandonment is an administrative decision based simply on a prosecution record. It occurs by operation of statute, 35 USC 133, and the passage of time. Contesting a holding of abandonment may be permitted but it is not an "adjudication *required* by statute" (emphasis added), 5 USC 554 (a)(1), and therefore cannot be an adversary adjudication under the Act.

Furthermore, even if the decisions sustaining the holding of abandonment were an adversary adjudication under the Act, it has not been shown that they were not substantially justified. As noted above, the decision of the Board of Appeals affirmed the examiner and resulted in an application in which all the claims were rejected. Applicants options after such a decision were clear. 37 CFR 1.197 permits reconsideration by the Board; and 35 USC 141 or 145 permits court review of the Board decision. Applicant chose not to exercise any of those options, any one of which would have forestalled abandonment and permitted clarification of the record with respect to the issue thereafter developed: the appropriateness of a terminal disclaimer.

Instead, applicant filed the terminal disclaimer, apparently trusting that its intrinsic sufficiency would be recognized. It was not. The application contained no allowed claims; the Board decision had not been reviewed. The conventional treatment of such applications is to hold them abandoned. Thus, the Group Director did support the holding of abandonment, and to

now find that holding not substantially justified would place so high a standard of correctness on some Patent and Trademark Office officials that they could no longer function. Within the framework of 35 USC 101, the actions of the office have been so sufficiently reasonable and substantially justified that an award of fees to petitioner would not be within the letter or the spirit of the Act.

Finally, legislative history shows that the Act is not appropriate to the routine functions of the Patent and Trademark Office, and these proceedings in particular. In House Report No. 96-1418, the Committee found that

> While the influence of the bureacracy over all aspects of life has increased, the ability of most citizens to contest any unreasonable exercise of authority has decreased. Thus, at the present time, the Government with its greater resources and expertise can in effect coerce compliance with its position. Where compliance is coerced, precedent may be established on the basis of an uncontested order rather than the thoughtful presentation and consideration of opposing views. In fact, there is evidence that small businesses are the target of agency action precisely because they do not have the resources to fully litigate the issue. This kind of truncated justice undermines the integrity of the decision making process.

(1980 U.S. Code Cong. and Adm. News, p. 8635). It would be difficult to maintain that petitioner was the target of agency action because it could not afford to litigate the rejection.

Appendix D—Decision of Deputy Assistant Commissioner for Patents.

CONCLUSION

The petition merits denial on the basis of the two procedural issues raised above. Furthermore, the petition merits denial on the basis that it is not directed to an adversary adjudication, and that the position of the agency was substantially justified.

This is an initial decision on the application for fees under 15 CFR 18.22. You have the right to review of this decision by the Office of the General Counsel, Department of Commerce, Washington D.C., 20230.

The petition is denied.

W. FELDMAN
William Feldman
Deputy Assistant Commissioner for Patents

Norman S. Blodgett
43 Highland St.
Worcester, Mass. 01608

APPENDIX E

Notice of Allowance and Issue Fee Due

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Received
Dec 10 1982
Blodgett & Blodgett, P.C.

Norman S. Blodgett
43 Highland St.
Worcester, Mass. 01608

All communications regarding this application should give the serial number, date of filing, name of applicant, and batch number.

Please direct all communications to the Attention of "OFFICE OF PUBLICATIONS" unless advised to the contrary.

The application identified below has been examined and found allowable for issuance of Letters Patent. *PROSECUTION ON THE MERITS IS CLOSED.*

SC/Serial No.: 05/728,129
Filing Date: 09/30/76
Total Claims: 004
Examiner and Group Art Unit: Lyddane, W. 355
Date Mailed: 12/07/82
First Named Applicant: Howitt, Robert T.
Title of Invention: Table
Atty's Docket No.: GD668
Class-Subclass: 108-025.000

Appendix E—Notice of Allowance and Issue Fee Due.

Batch No.: N78
Appln. Type: Utility
Small Entity: No
Fee Due: $500.00
Date Due: 03/07/83

The amount of the issue fee is specified by 37 C.F.R. 1.18 as follows: for an original or reissue patent, except for a design or plant patent, $500; for a design patent, $175; and for a plant patent, $250. If the applicant qualifies for and has filed a verified statement of small entity status in accordance with 37 C.F.R. 1.27, the issue fee is one-half the respective amount aforementioned. The issue fee due printed above reflects applicant's status as of the time of mailing this notice. A verified statement of small entity status may be filed prior to or with payment of the issue fee. However, in accordance with 37 C.F.R. 1.28, failure to establish status as a small entity prior to or with payment of the issue fee precludes payment of the issue fee in the amount so established for small entities and precludes a refund of any portion thereof paid prior to establishing status as a small entity.

THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE as indicated above. The application shall otherwise be regarded as ABANDONED. The issue fee will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the Patent and Trademark Office. Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of the notice of allowance, the issue fee is charged to the deposit account at the time of

mailing of this notice in accordance with 37 C.F.R. 1.311. If the issue fee has been so charged, it is indicated above.

In order to minimize delays in the issuance of a patent based on this application, *this Notice may have been mailed prior to completion of final processing.* The nature and/or extent of the remaining revision or processing requirements may cause slight delays of the patent. In addition, *if prosecution is to be reopened, this Notice of Allowance will be vacated and the appropriate Office action will follow in due course.* If the issue fee has already been paid and prosecution is reopened, the applicant may request a refund or request that the fee be credited to a Deposit Account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a Deposit Account.

In the case of each patent issuing without an assignment, the complete post office address of the inventor(s) will be printed in the patent heading and in the Official Gazette. If the inventor's address is now different from the address which appears in the application, please fill in the information in the space provided on PTOL-85b enclosed. If there are address changes for more than two inventors, enter the additional addresses on the reverse side of the PTOL-85b.

The appropriate spaces in the ASSIGNMENT DATA section of PTOL-85b must be completed in all cases. If it is desired to have the patent issue to an assignee, an assignment must have been previously submitted to the

Appendix E—Notice of Allowance and Issue Fee Due.

Patent and Trademark Office or must be submitted not later than the date of payment of the issue fee as required by 37 C.F.R. 1.334. Where there is an assignment, the assignee's name and address must be provided on the PTOL-85b to ensure its inclusion in the printed patent.

Advance orders for 10 or more printed copies of the prospective patent can be made by completing the information in Section 4 of PTOL-85b and submitting payment therewith. If use of a Deposit Account is being authorized for payment, PTOL-85c should also be forwarded. *The order must be for at least 10 copies and must accompany the issue fee.* The copies ordered will be sent only to the address specified in section 1 or 1A of PTOL-85b.

[ ] Note attached communication from Examiner.
[ ] This notice is issued in view of applicant's communication filed _____.

IMPORTANT

ATTENTION IS DIRECTED TO 37 C.F.R. 1.334

THE PATENT WILL ISSUE TO APPLICANT UNLESS AN ASSIGNEE IS SHOWN IN ITEM 3 ON FORM PTOL-85b, ATTACHED

YOUR COPY—See reverse side for Issue Fee Record

Appendix E—Notice of Allowance and Issue Fee Due.

U.S. Department of Commerce
Patent and Trademark Office

ISSUE FEE RECORD

This form is provided for optional use in recording information for your files. It is so designed that with use of carbon paper it may be filed in concurrently with the completion of the Issue Fee Transmittal Form PTOL-85b.

1.

1A. Further correspondence to be mailed to the following:

2A. The COMMISSIONER OF PATENTS AND TRADEMARKS is requested to apply the Issue Fee to the application identified below.

(Signature of party in interest of record) (Date)

Note: The Issue Fee will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the Patent and Trademark Office.

2B. For printing on the patent front page, list the names of not more than 3 registered patent attorneys or agents OR, alternatively, the name of a firm having as a member a registered attorney or agent. If no name is listed, no name will be printed.

1. _____

2. _____

3. _____

DO NOT USE THIS SPACE

Appendix E—Notice of Allowance and Issue Fee Due.

3. ASSIGNMENT DATA (print or type)

A. (1)[ ] This application is NOT assigned.

(2)[ ] Assignment previously submitted to the Patent and Trademark Office.

(3)[ ] Assignment submitted herewith.

B. *For Printing On The Patent:* (Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data below is only appropriate when an assignment has been previously submitted to the PTO or is submitted herewith. Completion of this form is NOT a substitute for filing of an assignment as required by 37 C.F.R. 1.334).

(1) NAME OF ASSIGNEE:

(2) ADDRESS: (City & State or Country)

(3) STATE OF INCORPORATION, IF ASSIGNEE IS A CORPORATION:

4. The following fees are enclose:

[ ] Issue fee [ ] Advanced order

[ ] Assignment recording

The following fees should be charged to deposit acc. no.____. (PTOL-85c or additional copy of PTOL-85b must be enclosed)

[ ] Issue fee

[ ] Advanced order

[ ] Assignment recording

Number of advanced order copies requested. _____

(must be for 10 or more copies)

Appendix E—Notice of Allowance and Issue Fee Due.

U.S. Department of Commerce
Patent and Trademark Office

ISSUE FEE TRANSMITTAL

1. Norman S. Blodgett
43 Highland St.
Worcester, Mass. 01608

SC/Serial No.: 05/728,129
Filing Date: 09/30/76
Total Claims: 004
Examiner and Group Art Unit: Lyddane, W 355
Date Mailed: 12/07/82
First Named Applicant: Howitt, Robert T.
Title of Invention: Table
Atty's Docket No.: GD668
Class-Subclass: 108-025,000
Batch No.: N78
Appln. Type: Utility
Small Entity: No
Fee Due: $500.00
Date Due: 03/07/83

1A. Further correspondence to be mailed to the following:

2A. The COMMISSIONER OF PATENTS AND TRADEMARKS is requested to apply the Issue Fee to the application identified below.

(Signature of party in interest of record) (Date)

Note: The Issue Fee will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the Patent and Trademark Office.

Appendix E—Notice of Allowance and Issue Fee Due.

2B. For printing on the patent front page, list the names of not more than 3 registered patent attorneys or agents OR, alternatively, the name of a firm having as a member a registered attorney or agent. If no name is listed, no name will be printed.

1. _____

2. _____

3. _____

DO NOT USE THIS SPACE

3. ASSIGNMENT DATA (print or type)

A. (1)[ ] This application is NOT assigned.

(2)[ ] Assignment previously submitted to the Patent and Trademark Office.

(3)[ ] Assignment submitted herewith.

B. *For Printing On The Patent:* (Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data below is only appropriate when an assignment has been previously submitted to the PTO or is submitted herewith. Completion of this form is NOT a substitute for filing of an assignment as required by 37 C.F.R. 1.334).

(1) NAME OF ASSIGNEE:

(2) ADDRESS: (City & State or Country)

(3) STATE OF INCORPORATION, IF ASSIGNEE IS A CORPORATION:

4. The following fees are enclose:

[ ] Issue fee [ ] Advanced order

[ ] Assignment recording

Appendix E—Notice of Allowance and Issue Fee Due.

The following fees should be charged to deposit acc. no._____: (PTOL-85c must be enclosed)

[ ] Issue fee
[ ] Advanced order
[ ] Assignment recording

Number of advanced order copies requested. _____
(must be for 10 or more copies)

TRANSMIT THIS FORM WITH PTOL-85b WHEN AUTHORIZING USE OF A DEPOSIT ACCOUNT

Appendix E—Notice of Allowance and Issue Fee Due.

U.S. Department of Commerce
Patent and Trademark Office

ISSUE FEE TRANSMITTAL

This form is provided in lieu of formal transmittal and should be used for transmitting the Issue Fee. Sections 1A through 4 must be completed as appropriate.

MAILING INSTRUCTIONS

All further correspondence including the Issue Fee Receipt, the Patent, and advanced orders will be mailed to the addressee entered in section 1 on PTOL-85c, unless you direct otherwise by specifying the appropriate name and address in 1A below.

INVENTOR(S) ADDRESS CHANGE:
SC/SERIAL NO.:
INVENTOR'S NAME:
Street Address
City, State and Zip Code
CO-INVENTOR'S NAME:
Street Address:
City, State and Zip Code:
[ ] Check if additional changes are on reverse side.

SC/Serial No.: 05/728,129
Filing Date: 09/30/76
Total Claims: 004
Examiner and Group Art Unit: Lyddane, W 355
Date Mailed: 12/07/82
First Named Applicant: Howitt, Robert T.
Title of Invention: Table
Atty's Docket No.: GD668
Class-Subclass: 108-025,000

Appendix E—Notice of Allowance and Issue Fee Due.

Batch No.: N78
Appln. Type: Utility
Small Entity: No
Fee Due: $500.00
Date Due: 03/07/83

1A. Further correspondence to be mailed to the following:

2A. The COMMISSIONER OF PATENTS AND TRADEMARKS is requested to apply the Issue Fee to the application identified below.

(Signature of party in interest of record) (Date)

Note: The Issue Fee will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the Patent and Trademark Office.

2B. For printing on the patent front page, list the names of not more than 3 registered patent attorneys or agents OR, alternatively, the name of a firm having as a member a registered attorney or agent. If no name is listed, no name will be printed.

1. _____

2. _____

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Appendix E—Notice of Allowance and Issue Fee Due.

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A. (1)[ ] This application is NOT assigned.

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(3)[ ] Assignment submitted herewith.

B. *For Printing On The Patent:* (Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data below is only appropriate when an assignment has been previously submitted to the PTO or is submitted herewith. Completion of this form is NOT a substitute for filing of an assignment as required by 37 C.F.R. 1.334).

(1) NAME OF ASSIGNEE:

(2) ADDRESS: (City & State or Country)

(3) STATE OF INCORPORATION, IF ASSIGNEE IS A CORPORATION:

4. The following fees are enclose:

[ ] Issue fee [ ] Advanced order

[ ] Assignment recording

The following fees should be charged to deposit acc. no._____ (PTOL-85c or additional copy of PTOL-85b must be enclosed)

[ ] Issue fee
[ ] Advanced order
[ ] Assignment recording

Number of advanced order copies requested. _____
(must be for 10 or more copies)

TRANSMIT THIS FORM WITH FEE

APPENDIX F

Notice of Allowability

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Received
Nov 24 1982
Blodgett & Blodgett, P.C.

Serial Number: 05/728,129
Filing Date: 09/30/76
First Named Applicant: Howitt R
Attorney Docket No.: GD668

Norman S. Blodgett
43 Highland St.
Worcester, Mass. 01608

Examiner: Lyddane, W
Art Unit: 355
Paper No.: 30
Date Mailed: 11/19/82

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

1. [ ] THIS IS AN ATTACHMENT TO THE NOTICE OF ALLOWANCE AND BASE ISSUE FEE DUE, PTOL 85.

2. [x] All the claims being allowable, PROSECUTION ON THE MERITS IS CLOSED in this application. If not attached hereto, a Notice of Allowance

or other appropriate communication will be sent in due course.

A. [ ] Note the attached PTO-152, Notice of Informality, which indicates that the declaration (or oath) is deficient and that a substitute is required. The substitute declaration (or oath) MUST BE SUBMITTED WITHIN THE THREE MONTH STATUTORY PERIOD SET FOR PAYMENT OF THE BASE ISSUE FEE IN THE "NOTICE OF ALLOWANCE AND BASE ISSUE FEE DUE" (PTOL-85), preferably with and attached to the base issue fee. Note that the statute does not permit extension of the three month period set for payment of the base issue fee. Failure to timely file the substitute declaration (or oath) will result in *ABANDONMENT* of the application. The transmittal letter accompanying the declaration (or oath) should indicate the following in the upper right hand corner:

Issue Batch Number; Date of the Notice of Allowance, and Serial Number.

B. [ ] Formal drawings are now required and MUST BE SUBMITTED WITHIN THE THREE MONTH STATUTORY PERIOD SET FOR PAYMENT OF THE BASE ISSUE FEE IN THE "NOTICE OF ALLOWANCE AND BASE ISSUE FEE DUE" (PTOL-85). Note that the statute does not permit extension of the three month period set to pay the base issue fee. Failure to timely submit the drawings will result in *ABANDONMENT* of the application. The drawings should be submitted as a separate paper with a transmittal letter which is addressed to the Official Draftsman and which indicates the following in the upper right hand corner:

Appendix F—Notice of Allowability.

Issue Batch Number; Date of the Notice of Allowance, and Serial Number.

C. [x] The claims are allowed in view of:

a. [x] Applicant's communication filed Nov. 19, 1980 and Board of Appeals decision of July 16, 1980.

b. [ ] The interview summarized on the attached EXAMINER INTERVIEW SUMMARY RECORD, PTOL-413.

c. [ ] The attached Examiner's Amendment.

d. [ ] An Examiner's Amendment which will follow in due course.

D. [x] The allowed claims are 13-16.

3. [ ] Note the attached Examiner's Statement of Reasons for Allowance.

4. [ ] Note attached NOTICE OF REFERENCES CITED, PTO-892, which is part of this communication. The listed references are considered to be pertinent to the claimed invention, but the claims are deemed to be patentable thereover.

5. [ ] Note attached LIST OF ART CITED BY APPLICANT, PTO-1449.

6. [ ] The drawings filed on _____ [ ] are acceptable as filed. [ ] are acceptable subject to correction as indicated on the attached Notice re Drawings, PTO-948. In order to avoid *ABANDONMENT* of this application, correction is required. Corrections *can only* be made in accordance with the instructions set forth in the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

Appendix F—Notice of Allowability.

7. [ ] The [ ] proposed drawing correction and/or the [ ] proposed additional or substitute sheet(s) of drawings filed on _____ has (have) been approved by the examiner. Applicant is reminded that in order to avoid abandonment of this applicant, execution of the proposed changes or submission of additional or substitute drawings *MUST* be made in accordance with the instructions set forth in the letter, "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474, attached to Paper No. _____.

8. [ ] The proposed drawing correction, filed _____, has been approved. However, the Patent and Trademark Office no longer makes drawing changes. It is now *applicant's responsibility* to ensure that the drawings are corrected. Corrections are required and MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

9. [ ] In order to avoid *ABANDONMENT*, the drawing informalities noted on the Notice re Drawing, PTO-948, attached to Paper No._____, must now be corrected. Applicant is reminded that the corrections can only be made in accordance with the instructions set forth in the letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474, attached to the PTO-948.

10. [ ] Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has: [ ] been received. [ ] not been received. [ ] been filed in parent application, Serial No. _____ filed on _____.

WILLIAM E. LYDDANE
William E. Lyddane
Primary Examiner
Art Unit 355

APPENDIX G

Decision on Petition

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

JN/DLS/lmf
Paper No. 28

Copy Mailed
Aug 3 1982
Deputy Asst. Comm.

Received
Aug 6 1982
Blodgett & Blodgett, P.C.

In re Application of
Robert T. Howitt
Serial No. 728,129
Filed: 9/30/76
For: TABLE

This is a decision on petition under 37 CFR 1.181, filed November 3, 1981, requesting review of the decision of the Director of Examining Group 350.

A review of the file record discloses that the Examiner's Answer, mailed September 27, 1978, rejected all claims under 35 U.S.C. 101 on the ground of "same invention" type double patenting rejection. That rejection cannot be overcome by a terminal disclaimer. The Board of Appeals decision, mailed July 16, 1980, stated that the rejection under 35 U.S.C. 101 would not be sustained. However, the Board of Appeals found that "obvious" type double patenting existed and therefore "affirmed" the examiner.

Appendix G—Decision on Petition.

The Board of Appeals decision inadvertently failed to state that the "obvious" type double patenting rejection was a new ground of rejection under 37 CFR 1.196(b). The rejection of the claims on "obvious" type double patenting must be considered a new ground since a terminal disclaimer can overcome that rejection. The Board of Appeals decision failed to set a period for response to the new ground of rejection. Therefore, under 37 CFR 1.136(a), petitioner had six months in which to respond to the new ground of rejection. The terminal disclaimer filed November 19, 1980 within that six month period was therefore timely. Therefore, the holding of abandonment is withdrawn.

The application file is being forwarded to Group 350.

The petition is granted.

W. FELDMAN
William Feldman
Deputy Assistant Commissioner for Patents

Norman S. Blodgett
43 Highland Street
Worcester, Massachusetts 01608

APPENDIX H

Decision on Second Request for Reconsideration

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Received
Jul 18 1981
Norman S. Blodgett

Mailed
Jul 16 1981
Director's Office
Group 350

Ex parte Robert T. Howitt
Serial Number 728,129
Filed September 30, 1976
For: TABLE

Applicant's request, filed July 6, 1981, requests reconsideration of the Director's holding in his letter of June 1, 1981 wherein there was a repeated denial of applicant's petition to withdraw a holding of abandonment and consider a terminal disclaimer.

Insofar as applicant's reliance on 37 C.F.R. 1.197(c) is concerned, the matter was fully discussed in the Director's decision of June 1, 1981. No error is found in that decision.

Applicant now raises a new issue in its reliance on 37 C.F.R. 1.196(b) in an attempt to show timeliness in filing the terminal disclaimer. Contrary to applicant's allegation, 37 C.F.R. 1.196(b) is not involved. The Board of Appeals in its decision stated "The rejection of the

claims as defining an obvious variation of the patent claims will, however, be sustained." It is clear that the Board was not setting forth a new ground of rejection under 37 C.F.R. 1.196(b). Hence the filing of the terminal disclaimer four months after the Board decision must be considered untimely.

Request for reconsideration granted.

Request for a change in the Director's decision is denied.

G. M. FORLENZA
G. M. Forlenza, Director
Patent Examining Group 350
General Constructions, Textiles,
Mining and Gearing

GMF:lkc

Norman S. Blodgett
43 Highland St.
Worcester, MASS. 01608

APPENDIX I

Decision on Request for Reconsideration

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Received
Jun 3 1981
Norman S. Blodgett

Mailed
Jun 1 1981
Director's Office
Group 350

Ex parte Robert T. Howitt
Serial Number 728,129
Filed September 30, 1976
For: TABLE

Applicant's request, filed May 1, 1981, requests reconsideration of the Director's decision of April 7, 1981 in which applicant's petition to withdraw the holding of abandonment and consider the terminal disclaimer was denied.

Upon due reconsideration, the Director's decision is adhered to. As previously indicated, the Terminal Disclaimer request was filed late on November 19, 1980 since proceedings in the application had been terminated prior thereto under 37 C.F.R. 1.197(c). Contrary to applicant's contention, the next step in the proceedings did not require action by the examiner. The record shows that the next step was up to applicant. Applicant's brief on appeal (page 13) held that there were two inventive concepts and that no terminal disclaimer was needed.

Appendix I—Decision on Request for Reconsideration.

The Board of Appeals held that there was only one inventive concept and thus affirmed the rejection of all claims in the case. Hence, the next step was up to applicant to either appeal the decision to avoid a terminal disclaimer or avoid abandonment by accepting the Board's decision and timely filing a terminal disclaimer.

G. M. FORLENZA
G. M. Forlenza, Director
Patent Examining Group 350
General Constructions, Textiles,
Mining and Gearing

GMF:lkc

Norman S. Blodgett
43 Highland St.
Worcester, Mass. 01608

APPENDIX J

Decision on Petition

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Received
Apr 18 1981
Norman S. Blodgett

Mailed
Apr 7 1981
Director's Office
Group 350

Ex parte Robert T. Howitt
Serial Number 728,129
Filed September 30, 1976
For: TABLE

Applicant's petition, filed March 23, 1981, requests a withdrawal of a holding of abandonment and consideration of the Terminal Disclaimer filed November 19, 1980.

The record shows that the Board of Appeals in a decision mailed July 16, 1980 held all claims in the case unpatentable. The Terminal Disclaimer request was filed late on November 19, 1980 since proceedings in the application had been terminated long prior thereto under 37 C.F.R. 1.197(c).

Petition to withdraw the holding of abandonment and consider the Terminal Disclaimer is denied.

G. M. FORLENZA
G. M. Forlenza, Director
Patent Examining Group 350
General Constructions, Textiles, Mining and Gearing

GMF:lkc

Norman S. Blodgett
43 Highland St.
Worcester, Mass. 01608

APPENDIX K

Notice of Abandonment

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Serial Number: 728129
Filing Date: 9-30-76
First Named Applicant: Howitt
Attorney Docket No.: GD668

Mailed	Received
Mar 2 1981	Mar 4 1981
Group 350	Norman S. Blodgett

Norman S. Blodgett
43 Highland St.
Worcester, Mass. 01608

Examiner: Lyddane
Art Unit: 355
Paper Number: ——
Date Mailed: ——

This application is abandoned in view of:

1. [ ] Applicant's failure to respond to the Office letter, mailed _____.

2. [ ] Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.

3. [ ] Applicant's failure to timely file the response received _____ within the period set in the Office letter.

Appendix K—Notice of Abandonment.

4. [ ] Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of _____ of the Notice of Allowance.

[ ] The issue fee was received on _____.

[ ] The issue fee has not been received in Allowed Files Branch as of _____.

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, the petition fee of $15, and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of Delgar Inc., V. Schuyler, 172 U.S.P.Q. 513.

5. [x] The reason(s) below.

BOARD DECISION.

WILLIAM E. LYDDANE
William E. Lyddane
Primary Examiner
Art Unit 355

APPENDIX L

Decision of the Board

Mailed
Jul 16 1980
Pat. & T.M. Office
Board of Appeals

Received
Jul 18 1980
Norman S. Blodgett

Art Unit 355
Appeal No. 380-34

Paper No. 17
LDJ

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Robert T. Howitt

Application for Patent filed September 30, 1976, Serial No. 728,129, which is a Continuation of Serial No. 546,327, filed February 3, 1975, Abandoned; which is a Division of Serial No. 404,772, filed October 9, 1973, now U. S. Patent No. 3,875,873. Table.

Norman S. Blodgett for appellant.

Before Messenheimer and Stahl, Examiners-in-Chief, and Arnold, Acting Examiner-in-Chief.

Arnold, Acting Examiner-in-Chief.

An appeal has been taken from the examiner's final rejection of claims 13 through 16, which are the only claims pending in the application.

Parent claim 13 is illustrative and reads as follows:

13. A table, comprising:

(a) a top having a flat upper surface, the top having at least three sockets extending downwardly therefrom,

(b) a plurality of legs, each one being adapted to fit tightly into one of the sockets, and

(c) a flange extending around the periphery of the top, the flange having at least two rectangular apertures arranged on opposite sides and adapted to receive all of the legs for storage in side-by-side relationship, the legs being of generally U-shaped thin-walled cross-sectional configuration and of plastic material, the cross-sectional shape of each leg being made up of a straight web from each end of which extends a straight flange lying at an obtuse angle to the web, the legs being stored in alternate up-an-down relationship.

References upon which the examiner has relied in rejecting the claims are:

Hathorne	1,262,339	Apr. 9, 1918
Lundy	1,726,992	Sep. 3, 1929
Mackey	3,244,125	Apr. 5, 1966
Manning	3,687,092	Aug. 29, 1972
Howitt	3,875,873	Apr. 8, 1975
Fienberg (Australian)	220,772	Mar. 23, 1959
Carrara et al (Carrara) (Italian)	475,275	Oct. 22, 1952
R.P.R.S. (Italian)	614,517	Dec. 31, 1960
Lesa (British)	768,496	Feb. 20, 1957

As stated on page 4 of the examiner's answer:

> "Independent claim 13 and dependent claims 14-16 stand rejected under 35 USC 101 on the ground of double patenting. These claims are not regarded as patentably distinguishing over the claims of applicant's prior U. S. Patent 3,875,873. This is a 'same invention' type double patenting rejection and cannot be overcome by a terminal disclaimer (MPEP 804.02)."

We construe the foregoing stated rejection as holding (1) that the claims on appeal are for the "same invention," or identical subject matter, as that defined by the claims of the Howitt patent and are rejected under 35 U.S.C. 101 and (2) that the claims on appeal "are not regarded as patentably distinguishing over the claims of applicant's prior U. S. Patent 3,875,873," thus defining an obvious variation of the invention claimed in the Howitt patent and are therefore rejected as "double patenting." *In re* Vogel, 57 CCPA 920, 422 F.2d 438, 164 USPQ 619 (1970).

The rejection of the claims on the ground they define the "same invention" as that defined by the claims of the patent is not tenable. The test for making such determination, as set forth in Vogel, *supra*, is:

> ". . . whether one claim could be literally infringed without literally infringing the other; if it could be, claims do not define identically the same invention."

Applying this test to the facts here involved we find that a claim of the patent which defines a "side-by-side" arrangement for the legs while in storage could be infringed without infringing the claims on appeal which

define the storage position of the legs as in "alternate up-and-down relationship." The claims on appeal therefore are not directed to the "same invention." The rejection under 35 U.S.C. 101 will not be sustained.

The rejection of the claims as defining an obvious variation of the patent claims will, however, be sustained.

We call attention first to the fact that no terminal disclaimer has been filed. Appellant expresses the view on page 13 of the brief that:

> "... the claims in question define two inventive concepts, so that there is no double patenting and no terminal disclaimer is needed."

We are not convinced that two inventive concepts are involved. A comparison of the subject matter defined by the claims on appeal and that claimed in appellant's patent No. 3,875,873 discloses only that, whereas, the patent claims define the legs in their stored position as lying in "side-by-side" relation, the claims on appeal define them as stored in "alternate up-and-down relationship." Since the original disclosure is only that of an "alternate up-and-down relationship," we construe the broader recitation of the "side-by-side" relation in the patent claims to be generic to the "alternate up-and-down relationship" now being claimed. *In re* Vogel, *supra.*

Appellant states in the last three lines of page 14 of the brief that:

> "... an even greater spring effect is produced when the legs are not stored in alternating up and down relationship to produce a tighter fit, if desired."

Such arrangement is not included in the original disclosure. This would appear to be an afterthought for which there is no mention in the original disclosure. Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 148 USPQ 459 (S.Ct. 1966).

Since we agree with the examiner's position that the claims on appeal differ from the claims of appellant's patent in scope only, the rejection of the claims as "not . . . patentably distinguishing over the claims of applicant's prior U. S. Patent 3,875,873" will be sustained.

All claims on appeal stand further rejected under 35 U.S.C. 103 as unpatentable over Manning in view of Lesa, variously combined with Hathorne, Lundy, Carrara, Mackey, Fienberg and Italian reference No. 614,517 as set forth on pages 4, 5 and 6 of the examiner's answer to which reference is made. We have reviewed such rejection of the claims in light of the arguments presented in the brief on appeal and have concluded that such rejection involves error.

The examiner states in lines 4-9 of page 5 of the answer that:

> ". . . the particular shape of the legs and the material from which they are made are regarded as being simply matters of design choice since no new or unobvious result is seen to extend therefrom, but legs shaped as claimed are shown to be old by Hathorne (note leg 2 in Figs. 2 and 4) and Lundy (note Figs. 1 and 2)."

We do not share the view that "... the particular shape of the legs and the material from which they are made ..." are "... simply matters of design choice ..." in this instance. Neither the Hathorne nor Lundy patent, combined with Lesa, discloses or suggests U-shaped legs of plastic having a thin-walled cross-sectional configuration, with flanges obtusely related to the web portion, stored in "alternate up-and-down relationship." As argued by appellant, such arrangement provides tightly holding stored legs in a manner not taught by the prior art. Accordingly, the rejection of claims 13 through 16 made under 35 U.S.C. 103 will not be sustained.

The decision of the examiner, rejecting claims 13 through 16 as failing to patently distinguish over appellant's prior patent, is affirmed.

AFFIRMED

A.D. MESSENHEIMER)
Examiner-in-Chief)
)
ROBERT F. STAHL) BOARD
Examiner-in-Chief) OF
) APPEALS
P. ARNOLD)
Examiner-in-Chief)
(Acting))

Norman S. Blodgett
43 Highland Street
Worcester, MA 01608

APPENDIX M

Advisory Action

(Logo)

U.S. DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Mailed
May 18 1978
Group 350

Paper No. 12
Mailed

In Reply Please Refer To The Following:

Examiner's Name: Lyddane
Gr. Art Un.: 355
Filing Date: 9-30-76
Serial No.: 728,129
Applicant: Robert T. Howitt
Invention: TABLE

Norman S. Blodgett
43 Highland St.,
Worcester, Mass. 01608

Below is a communication from the EXAMINER in charge of this application.

Commissioner of Patents, and Trademarks

[x] THE PERIOD FOR RESPONSE IS EXTENDED TO RUN FOUR MONTHS *FROM THE DATE OF THE FINAL REJECTION.* 855 O.G. 1109.

[ ] Appellant's Brief is due in accordance with Rule 192(a).

Appendix M—Advisory Action.

Applicant's response to the final rejection, filed May 2, 1978, has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. [ ] The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

a. [ ] There is no convincing showing under Rule 116(b).

b. [ ] They raise new issues that would require further consideration and/or search.

c. [ ] They raise the issue of new matter.

d. [ ] They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

e. [ ] They present additional claims without cancelling a corresponding number of finally rejected claims.

2. [ ] Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. [x] Upon the filing of an appeal, the proposed amendment [x] will be [ ] ~~will not be~~ entered and the status of the claims in this application would be as follows:

a. [ ] Claims None would be allowable.

b. [x] Claims 13-16 would not be allowable.

However:

(1) [ ] The rejection of claims _____ on references is deemed to be overcome by applicant's response.

Appendix M—Advisory Action.

(2) [ ] The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. [ ] The affidavit, exhibit or request for reconsideration has been entered but does not overcome the rejection.

5. [ ] The affidavit or exhibit will not be admitted because applicant has not shown good and sufficient reasons why it was not earlier presented.

6. [ ] The application having been examined under the special accelerated examining procedure (M.P.E.P. 708.02), the proposed amendment has not been considered since it does not prima facie place the application in condition for allowance or in better condition for appeal.

ROY D. FRAZIER
Roy D. Frazier
Supervisory Patent Examiner
Art Unit 355

APPENDIX N

Final Rejection, Dated February 13, 1978

(Logo)

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Mailed
Feb 16 1978
Group 350

Paper No. 10
Mailed

W. Lyddane 355
09/30/76 728,129

Norman S. Blodgett
43 Highland Street
Worcester, Mass. 01608

This is a communication from the examiner in charge of your application.

Commissioner of Patents and Trademarks

[ ] This application has been examined.

[x] Responsive to communication filed on Dec. 22, 1977.

[x] This action is *made final.*

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTH(S) _____ DAYS FROM THE DATE OF THIS LETTER.

FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED. 35 U.S.C. 133

Appendix N—Final Rejection, Dated February 13, 1978.

PART I

THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. [ ] Notice of References Cited, Form PTO-892.
2. [ ] Notice of Informal Patent Drawing, PTO-948.
3. [ ] Notice of Informal Patent Application, Form PTO-152.
4. [ ]

PART II

SUMMARY OF ACTION

1. [x] Claims 13-16 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. [x] Claims 1-12 have been cancelled.

3. [ ] Claims _____ are allowed.

4. [x] Claims 13-16 are rejected.

5. [ ] Claims _____ are objected to.

6. [ ] Claims _____ are subject to restriction or election requirement.

7. [ ] The formal drawings filed on _____ are acceptable.

8. [ ] The drawing correction request filed on _____ has been [ ] approved. [ ] disapproved.

9. [ ] Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has [ ] been received. [ ] not been received. [ ] been filed in parent application: serial no. _____ filed on _____.

Appendix N—Final Rejection, Dated February 13, 1978.

10. [ ] Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 OG. 213.

11. [ ] Other

1. Independent claim 13 and dependent claims 14-16 are rejected under 35 USC 101 on the ground of double patenting. These claims are not regarded as patentably distinguishing over the claims of applicant's prior U. S. Patent 3,875,873. This is a "same invention" type double patenting rejection and cannot be overcome by a terminal disclaimer (MPEP 804.02).

2. Independent claim 13 and dependent claim 14 are rejected under 35 USC 103 as being unpatentable over Manning in view of Lesa taken with or without any of Hathorne, Lundy, or Carrara et al. These claims distinguish over the table structure of Manning only by the flanges having apertures "adapted to receive" legs for storage and the particular shape of the legs. Lesa teaches a tabletop having depending flanges 2 with leg receiving openings 8 to retain the legs in wedge fashion in a stored position underneath the tabletop (see lines 67-71). It would be well within the ambit of one having ordinary skill in the art to modify the table structure of Manning to include leg receiving storage apertures below the tabletop as taught by Lesa, the particular shape of the legs and the material from which they are made are regarded as being simply matters of design choice since no new or unobvious result is seen to extend therefrom, but legs shaped as claimed are shown to be old by

Appendix N—Final Rejection, Dated February 13, 1978.

Hathorne (note leg 2 in Figs. 2 and 4) and Lundy (note Figs. 1 and 2). Note also that stored orientation of the legs in alternate up-and-down relationship is also regarded as being a matter of choice but would be obvious in view of the alternating positions of Lesa (Fig. 1). In regard to claim 14, the particular shape of the tabletop is regarded as simply a matter of design choice, but Carrara et al show substantially triangular tabletops to be old and well-known.

3. Claim 15 is rejected under 35 USC 103 as being unpatentable over Manning in view of Lesa taken with or without any of Hathorne, Lundy, or Carrara et al, and Mackey. Further modification of the tabletop of Manning to include glass and snack receiving recesses would be obvious in view of the teachings of Mackey, the particular shapes thereof being simply matters of design choice.

4. Claim 16 is rejected under 35 USC 103 as being unpatentable over Manning in view of Lesa, taken with or without any of Lundy, Hathorne, Fienberg, or McCart and Italian reference No. 614,517. This claim distinguishes over the table structure of Manning as modified above by the leg sockets having a non-circular cross-section and by the legs extending at an angle from the reduced upper portion, both limitations being regarded as obvious design modifications for one of ordinary skill in the art, particularly in view of Fienberg (Figs. 2 and 4) which shows forming a leg receiving socket 10b with a non-circular cross-section to receive a complementary shaped reduced portion of a leg to

prevent rotation thereof, and the Italian reference 614,517 which shows the claimed angular relationship between portions of the leg to be old. Note that to make the leg receiving socket to have a rectangular cross-section, as taught by McCart (Fig. 3), to receive a substantially U-shaped leg would be an obvious extension of the teachings of Feinberg.

5. The above rejection, which was made over the art of record, is considered to be appropriate and is hereby made *FINAL*.

ROY D. FRAZIER
Supervisory Patent Examiner
Art Unit 355

W. Lyddane/akh
(703) 557-0540
2/13/78

APPENDIX O

Communication from Examiner

(Logo)

U.S. DEPARTMENT OF COMMERCE

Patent Office

Address Only: Commissioner of Patents
Washington, D.C. 20231

Paper No. 7

W. Lyddane Art Unit 355
Sept. 30, 1976 728 129

Robert T. Howitt

TABLE

Norman S. Blodgett
43 Highland St.
Worcester Mass. 01608

Mailed
Oct 18 1977
Group 350

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE 3 MONTHS, DAYS FROM THE DATE OF THIS LETTER.

The second page of the office action dated August 24, 1977 is herewith submitted. The error is regretted.

The office apparently sent to you two pages of page 3. If so, we would appreciate the return of that copy.

M. Oliver
Clerk, Group 350

APPENDIX P

Rejection

(Logo)

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

Mailed
Aug 24 1977
Group 350

Paper No. 5
Mailed

W. Lyddane 355
09/30/76 728,129
Robert T. Howitt

Norman S. Blodgett
43 Highland Street
Worcester, Mass. 01608

This is a communication from the examiner in charge of your application.

Commissioner of Patents and Trademarks

[x] This application has been examined.

[ ] Responsive to communication filed on _____.

[ ] This action is *made final.*

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTH(S) ==== DAYS FROM THE DATE OF THIS LETTER.

FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED. 35 U.S.C. 133

Appendix P—Rejection.

PART I

THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. [x] Notice of References Cited, Form PTO-892.
2. [ ] Notice of Informal Patent Drawing, PTO-948.
3. [ ] Notice of Informal Patent Application, Form PTO-152.
4. [ ]

PART II

SUMMARY OF ACTION

1. [x] Claims 8-12 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. [x] Claims 1-7 have been cancelled.

3. [ ] Claims _____ are allowed.

4. [x] Claims 8-12 are rejected.

5. [ ] Claims _____ are objected to.

6. [ ] Claims _____ are subject to restriction or election requirement.

7. [ ] The formal drawings filed on _____ are acceptable.

8. [ ] The drawing correction request filed on _____ has been [ ] approved. [ ] disapproved.

9. [ ] Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has [ ] been received. [ ] not been received. [ ] been filed in parent application: serial no. _____ filed on _____.

Appendix P—Rejection.

10. [ ] Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 OG. 213.

11. [ ] Other

PART III

NOTIFICATION OF REJECTION(S) AND/OR OBJECTION(S) (35 USC 132)

Serial Number: 728,129
Group Art Unit: 355

1. Claims (1): 8--12

Reasons for Rejection (2): 35 USC 132

References* (3): ——

Information Identification and Comments (4): These claims are rejected on the ground of new matter in that the expression "and of an elastomer . . . place" (lines 10-12) is regarded as new matter as contemplated by 35 USC 132 since the is no support therefor in the originally [see 5 below]

2. ——

3. ——

4. ——

5. filed descriptive portion of the specification or the originally filed claims. See MPEP 608.04.

6. D is cited to show leg structure similar to that of applicant's device. A-C, E-I, and L-Q are cited as being of record in the parent application.

Appendix P—Rejection.

Examiner: W. E. Lyddane
Tel. No.: (703) 557-0540

* Capital letters representing references are identified on accompanying Form PO-892.

The symbol "v" between letters represents - in view of -.

The symbol "+" or "&" between letters represents - and -.

A slash "/" between letters represents the alternative - or -.

Note: Sections 100, 101, 102, 103 and 112 of the Patent Statute (Title 35 of the United States Code) are reproduced on the back of this sheet.

Appendix P—Rejection.

NOTICE OF REFERENCES CITED

U.S. Department of Commerce
Patent and Trademark Office

To separate, hold top and bottom edges, snap—apart and discard carbon

Serial No.: 728,129
Group Art Unit: 355
Attachment to Paper Number: 5
Applicant(s): R. T. Howitt

U.S. PATENT DOCUMENTS

	Document No.	Date	Name	Class	Sub-Class	Filing Date If Appropriate
A	117277	7-1871	Hallowell et al	108	156	
B	1262339	4-1918	Hathorne	248	188	
C	1414575	5-1922	McCart	248	165	
D	1726992	9-1929	Lundy	248	188x	
E	1978650	10-1934	Shannon	108	156	
F	3244125	4-1966	Mackey	108	25	
G	3604371	9-1971	Cavalucci	108	156	
H	3687092	8-1972	Manning	108	156	
I	3875873	4-1975	Howitt	108	25	
J	——					
K	——					

Appendix P—Rejection.

FOREIGN PATENT DOCUMENTS

	Document No.	Date	Country	Name	Class	Sub-Class	Pertinent Shts. Dwg.	Pertinent PP. Spec.
L	220772	10-1957	Australia	Fienberg	108	156		
M	475275	10-1952	Italy	Carrara et al	108	156		
N	504382	7-1954	Canada	Bronstein	248	188		
O	614517	12-1960	Italy		248	188		
P	768496	2-1957	Britain	Lesa	108	156		
Q	1131884	2-1957	France	Schluckebier	403	363		

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

R ——

S ——

T ——

U ——

Examiner W. E. Lyddane

Date: 8-17-77

* A copy of this reference is not being furnished with this office action. (See Manual of Patent Examining Procedure, section 707.05(a).)

APPENDIX Q

Judgment of the United States Court of Appeals for the Federal Circuit

Received
Mar 25 1987
Blodgett & Blodgett, P.C.

Appeal No. 86-1671.

IN RE ROBERT T. HOWITT.

ON APPEAL from the General Counsel for the Department of Commerce in Case No(s). Serial No. 728,129

This CAUSE having been heard and considered, it is ORDERED and ADJUDGED: DISMISSED

ENTERED BY ORDER OF THE COURT

FRANCIS X. GINDHART
Francis X. Gindhart, Clerk

Dated Feb 18 1987

ISSUED AS A MANDATE: March 23, 1987
COSTS: Against, Appellant
PRINTING..... $120.26
TOTAL..... $120.26

Appendix Q—Judgment of the United States Court of Appeals for the Federal Circuit.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BILL OF COSTS

Received
Mar 25 1987
Blodgett & Blodgett, P.C.

An original and three copies of a bill of costs is due to be filed in this office *within 14 days after entry of judgment* (FRAP 39). A late bill of costs cannot be processed unless accompanied by a motion showing good cause. Objections must be filed within 10 days of service of the bill on the party against whom costs are to be taxed.

IN RE RICHARD T. HOWITT
Appellant (Petitioner)

xxxxxxxxxxxxxx
Appellee (Respondent)

Appeal Docket No. 86-1671

The Clerk is requested to tax the following costs against: Appellant Howitt

COSTS TAXABLE UNDER FRAP 39
and 28 USC 1920

REQUESTED

Item
Appellee's Brief
No. of Documents: 14
Pages Per Document: 98 (inc. App.)
Cost Per Page: 8¢
Total Cost: $109.76

Appendix Q—Judgment of the United States Court of Appeals for the Federal Circuit.

Other (describe): Binding
No. of Documents: 14
Cost Per Page: $.75/copy
Total Cost: $10.50

Total: $120.26

ALLOWED

Cost are Taxed in the amount of $120.26
(JC 3/23/87)

City/State of District of Columbia }
County of_____ } SS

I John Fargo swear under penalty of perjury that the services for which costs are taxed were necessarily performed and the cost of printing or reproducing the documents is no higher than charges in the Washington, D.C. area. If printed, an itemized statement of the printer showing actual costs per page for the document is attached. If the documents were copies, an itemized statement of the copying costs is attached. A copy of this bill was mailed this day to opposing counsel.

Received
Feb 19 1987
United States of Appeals
For the Federal Circuit

Filed
U.S. Court of Appeals for
the Federal Circuit
Feb 19 1987
Francis X. Gindhart
Clerk

February 19, 1987
Date

JOHN FARGO
Signature
Attorney for The United States

Appendix Q—Judgment of the United States Court of Appeals for the Federal Circuit.

CERTIFICATE OF SERVICE

I certify that true copies of the foregoing Bill Of Costs were sent by first-class, postage prepaid mail this 19th day of February, 1987, to:

Gerry A. Blodgett, Esq.
Blodgett and Blodgett
43 Highland Street
Worchester, MA 01609

JOHN FARGO
John Fargo
Assistant Director
Commercial Litigation Branch
Civil Division
Department of Justice
Washington, D. C. 20530
Telephone: (202) 724-7415

APPENDIX R

Order of the United States Court of Appeals for the Federal Circuit

Received
Mar 18 1987
Blodgett & Blodgett, P.C.

Appeal No. 86-1671.

IN RE ROBERT T. HOWITT,
Appellant.

Before MARKEY, *Chief Judge*, RICH and NIES, *Circuit Judges*.

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, denied.

FOR THE COURT

FRANCIS X. GINDHART
Francis X. Gindhart, Clerk

3/16/87
Date

cc: Mr. Gerry A. Blodgett
Mr. Vito DiPietro, DOJ

APPENDIX S

Denial of Petition

Filed
U.S. Court of Appeals for
the Federal Circuit
May 7 1987
Francis X. Gindhart
Clerk

Received
May 7 1987
United States Court of Appeals
For the Federal Circuit

Received
May 15 1987
Blodgett & Blogett, P.C.

Appeal No. 86-1671.

IN RE ROBERT T. HOWITT.

SUPPLEMENTAL PETITION TO
RECALL MANDATE

Petitioner supplements its PETITION TO RECALL AND, CORRECT OR CLARIFY MANDATE and now also petitions alternatively that the Court Mandate be recalled for the purpose of allowing Petitioner to file a Motion for a rehearing *en banc*, on this first impression question of this Court's jurisdiction.

Appendix S—Denial of Petition.

GROUNDS

This Court recently published its opinion in *Wyden v. Commissioner of Patents and Trademarks,* 231 U.S.P.Q. 918 (C.A.F.C. 1986). The 10 judge panel which sat on that case ruled that the Court of Appeals for the Federal Circuit would construe its jurisdiction under 28 U.S.C. §1295 (a)(2) broadly. Chief Judge Markey wrote an impassioned dissent in that case opining that the liberal interpretation

cc: Gerry A. Blodgett, Esq.
Vito DiPietro, Esq.
John Fargo, Esq.

Not To Be Published In A Reporter

Denied
For the Court
5/13/87
Francis X. Gindhart
Clerk

Filed
U.S. Court of Appeals for
the Federal Circuit
May 13 1987
Francis X. Gindhart
Clerk

APPENDIX T

Examiner's Answer Before the Board of Appeals

Paper No. 15

(Logo)

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: Commissioner of Patents and Trademarks
Washington, D.C. 20231

All communications respecting this application should give the serial number, date of filing and name of the applicant.

Robert T. Howitt

Before the Board of Appeals

NORMAN S. BLODGETT

FOR
APPELLANT

---

1. This is an appeal from the refusal to allow claims 13-16 as amended in paper No. 11, dated May 2, 1978, which has been entered for purposes of appeal.

2. A correct copy of the appealed claims appears on pages 1 and 2 of the brief, with the exception of claim 16 which is reproduced below:

Claim 16. A table as recited in Claim 13, wherein each socket is of non-circular cross-section and each leg is provided with an upper portion of reduced, non-circular

cross-sectional shape which is shape-conforming to the sockets and which extends at a substantial angle to the remainder, [2] so that, when the upper portion of each leg is in its socket, the legs extend in a non-parallel manner to each other, spreading in the downward direction, and are not rotatable in the socket.

3. The references of record relied upon are:

1,262,339	Hathorne	04-1918
1,726,992	Lundy	09-1929
3,244,125	Mackey	04-1966
3,687,092	Manning	08-1972
3,875,873	Howitt	04-1975
220,772	Fienberg (Australia)	10-1957
475,275	Carrara et al (Italy)	10-1952
614,517	R.P.R.S. (Italy)	12-1960
768,496	Lesa (Great Britain)	02-1957

4. *DESCRIPTION OF THE PRIOR ART*

The patents to Hathorne (Figures 2 and 4) and Lundy (Figures 1 and 3) are applied to show the conventionality of support legs having a generally U-shaped thin-walled cross-sectional configuration.

The patent to Mackey is applied to show glass and snack [3] receiving recesses in a tabletop to be old and well known in the art.

Appendix T—Examiner's Answer Before the Board of Appeals.

The patent to Manning (Figure 1) teaches a light weight, molded plastic table including a plurality of downwardly extending sockets 20, a plurality of legs 25 removably received within the sockets, and a peripheral flange 12, 13 extending downwardly from the table top.

The patent to Howitt is Appellant's prior patent disclosing and claiming the same subject matter as the instant application.

The Australian patent to Fienberg (Figures 2 and 4) shows table structure having leg receiving sockets 10b with non-circular cross-sections to receive complementary shaped portions 11a of the legs to prevent rotation thereof as being old and well known in the art.

Italian patent 475,275 to Carrara et al is applied to show the conventionality of triangularly shaped tabletops for tables having removable legs.

The Italian reference 614,517 to R.P.R.S. teaches the use of support legs having an upper portion 4' extending at an angle to the lower portion 4 so that when the upper portion is inserted into a socket 3 of the surface to be supported the legs extend in a non-parallel manner to each other.

[4] The British patent to Lesa (Figure 1) teaches table structure including removable legs 5 which may be stored in openings 8 of downwardly extending flanges 2 by wedging therein.

Appendix T—Examiner's Answer Before the Board of Appeals.

5. *GROUNDS OF REJECTION*

Independent claim 13 and dependent claims 14-16 stand rejected under 35 USC 101 on the ground of double patenting. These claims are not regarded as patentably distinguishing over the claims of applicant's prior U. S. Patent 3,875,873. This is a "same invention" type double patenting rejection and cannot be overcome by a terminal disclaimer (MPEP 804.02).

Independent claim 13 and dependent claim 14 stand rejected under 35 USC 103 as being unpatentable over Manning in view of Lesa taken with or without any of Hathorne, Lundy, or Carrara et al. These claims distinguish over the table structure of Manning (Figures 1) only by the flanges having apertures "adapted to receive" legs for storage and the particular shape of the legs. Lesa (Figures 1) teaches a tabletop having depending flanges 2 with leg receiving openings 8 to retain the legs in wedge fashion in a stored position underneath the tabletop (see lines 67-71). It would be well [5] within the ambit of one having ordinary skill in the art to modify the table structure of Manning to include leg receiving storage apertures below the tabletop as taught by Lesa, the particular shape of the legs and the material from which they are made are regarded as being simply matters of design choice since no new or unobvious result is seen to extend therefrom, but legs shaped as claimed are shown to be old by Hathorne (note leg 2 in Figs. 2 and 4) and Lundy (note Figs. 1 and 2). Note also that stored orientation of the legs in alternate up-and-down relationship is also regarded as being a matter of choice but would be

obvious in view of the alternating positions of Lesa (Fig. 1). In regard to claim 14, the particular shape of the tabletop is regarded as simply a matter of design choice, but Carrara et al show substantially triangular tabletops to be old and well-known.

Claim 15 stands rejected under 35 USC 103 as being unpatentable over Manning in view of Lesa taken with or without any of Hathorne, Lundy, or Carrara et al, and Mackey. Further modification of the tabletop of Manning to include glass snack receiving recesses would be obvious in view of the teachings of Mackey, the particular shapes thereof being simply matters of design choice.

[6] Claim 16 stands rejected under 35 USC 103 as being unpatentable over Manning in view of Lesa, taken with or without any of Lundy, Hathorne, or Fienberg, and Italian reference No. 614,517. This claim distinguishes over the table structure of Manning as modified above by the leg sockets having a non-circular cross-section and by the legs extending at an angle from the reduced upper portion, both limitations being regarded as obvious design modifications for one of ordinary skill in the art, particularly in view of Fienberg (Figs. 2 and 4) which shows forming a leg receiving socket 10b with a non-circular cross-section to receive a complementary shaped reduced portion 11a of a leg to prevent rotation thereof, and the Italian reference 614,517 which shows the claimed angular relationship between portions of the leg to be old. Note that to make the leg receiving socket to have a cross-section capable of receiving a U-shaped leg is regarded as being within the level of skill in the art.

Appendix T—Examiner's Answer Before the Board of Appeals.

6. *ANSWERS TO APPELLANT'S ARGUMENTS*
35 USC 101 "Same Invention" Double Patenting

At the outset, it should be noted that the instant application was a continuation of SN 546,327, (Filed under [7] 37 CFR 1.60) which was a division of SN 404,772 (also filed under 37 CFR 1.60), and SN 404,772 is now U.S. patent No. 3,875,873 applied in the above rejection under 35 USC 101. Therefore, the disclosure of the instant application is *identical* to the disclosure of Appellant's prior patent 3,875,873, and the same *combination* of elements are recited in the appealed claims as well as the claims of the patent, the only difference being in the scope of the claims. It should also be noted that although Appellant term SN 546,327 a *division* of parent SN 404,772, in fact there was no divisible subject matter carved out of the parent nor was there any to carve out. Restriction was *not* required in the parent case.

The chart appearing on page 11 of the brief setting forth distinctions between the invention claimed in claim 1 of Appellant's patent No. 3,875,873 and that set forth in appealed claim 13 is deficient for the following reasons. Comparison of claim 1 of the patent with claim 13 of the instant application is misleading since the significant parts of claim 13 (identified as O,P, and R in the chart) are recited in other claims of the patent. In fact, the claim from the patent which should have been compared with claim 13 of the instant application is claim 3. Since [8] claim 3 depends from claim 2, which depends from claim 1, it includes all of the limitations of portions A through N of the chart (claim 1), portions O

and P of the chart (claim 2) and portion R of the chart (claim 3). The only limitations which claim 13 of the instant application has that claim 3 of the patent doesn't have is the legs being "of plastic material" (portion Q of the chart) and "the legs being stored in alternate up-and-down relationship" (last part of portion R of the chart) which are considered to be immaterial limitations since there is no disclosure of any alternate material for the legs nor alternate orientation of the legs in the stored position present in the disclosure of the patent.

In view of Appellant's chart on page 11 of the brief and the above discussion, it is clear that (contrary to the remarks in paragraph 1, page 12 of the brief) a device limited to the combination of elements in *Claim 3* of patent No. 3,875,873 constructed in accordance with the disclosure thereof would infringe claim 13 of the instant application. Claim 3 of the patent and appealed claim 13 are to exactly the same combination of elements and differ only in minor ways as noted above. Therefore, the rejection of the claims under 35 USC 101 on the ground of double patenting is proper.

Furthermore, it should be noted that if a licensee were to license patent No. 3,875,873 to use the structure of [9] claim 3 in accordance with the disclosure of the patent, he would also be required to license a second patent (if one were issued on claim 13) in order to practice the invention. The best interest of the public would not be served by granting a second patent which would require a licensee to license two patents to make the single invention disclosed and claimed in one of the patents.

Appendix T—Examiner's Answer Before the Board of Appeals.

35 USC 103 "Obviousness" Rejection

Beginning with the description of the invention on pages 3-5 of the brief and continuing throughout the brief, Appellant makes statements and arguments regarding an alleged "resiliency" of the flanges of the legs which retains the legs within the apertures. However, there is absolutely no disclosure in the written description, drawings, or originally filed claims to provide basis for this allegation. Particularly, in the description on page 5 of the brief, lines 10-16, the statements "The angular flanges function as leaf springs to hold the legs in place within the apertures. "and" The material from which the legs are made and the particular cross-sectional configuration of the legs provides a leg which is light, [10] yet sturdy and has a degree of resiliency when stored in side-by-side relationship within the apertures in the table top flange." do not have any basis in the originally filed disclosure. Other similar non-factual statements regarding the alleged "resiliency" of the legs will be treated below in responses to arguments set forth in the brief.

The discussion of the U-shaped legs of the stool of the Hathorne patent on page 7 of the brief concludes with the statement that "stiffness rather than resiliency is a prime consideration in the design of the stool legs". However, this comment is not pertinent since Appellant has no disclosure of any desirability of any "resiliency" of the U-shaped legs of his device, nor do his claims recite any such "resiliency".

Appendix T—Examiner's Answer Before the Board of Appeals.

The arguments on page 14 of the brief concerning the combination of Manning and Lesa in the rejection under 35 USC 103 are not pertinent since every point emphasized in lines 10-24 regards the "resiliency" of the legs and the "spring effect" which they provide, which are not features of the invention recited in any claim nor are such features apparent from any portion of the disclosure.

Appellant's arguments on pages 15 and 16 of the brief, [11] regarding the patents to Hathorne and Lundy are not persuasive. Appellant has not shown that the legs of the device of the instant application have any "resiliency" which the U-shaped legs of the patents to Hathorne and Lundy do not have. Furthermore, it is not seen that the legs taught in the patents to Hathorne and Lundy would be found unsuitable for side-by-side storage by one having ordinary skill in the art in view of the teachings of Lesa.

O ice again, the arguments regarding claim 13 on pages 16 and 17 of the brief includes the "resiliency" of the legs (note lines 10-12, page 16 of the brief) which is not properly arguable since such limitation is not recited in the claim: . Furthermore, the arguments on pages 16-18 of the brief are directed to the individual references and not to the combination of references applied in the rejections of the claims under 35 USC 103.

In conclusion, it is maintained that the above discussion and comparison of claim 3 of patent No. 3,875,873 with appealed claim 13 elucidates the propriety of the "same invention" double patenting rejection.

Appendix T—Examiner's Answer Before the Board of Appeals.

Furthermore, it is clear that Appellant's arguments for unobviousness are predicated on the alleged "resiliency" of the U-shaped legs and the "spring effect" which they provide. Since such alleged differences over the prior art as applied under [12] 35 USC 103 form no part of the originally filed disclosure, and neither are recited nor could be recited as limitations in the appealed claims, the arguments are without ground and the rejection of the claims under 35 USC 103 is proper.

7. It is submitted that the claims on appeal have been properly rejected under both 35 USC 101 and 35 USC 103 and that the rejection of all claims on appeal be sustained.

Respectfully submitted,

ROY D. FRAZIER
Roy D. Frazier
Supervisory Patent Examiner
Art Unit 355

WEL
W. Lyddane:dsm
(703) 557-0540
Sept. 18, 1978

Supreme Court, U.S.
FILED
AUG 12 1987
JOSEPH F. SPANIOL, JR.
CLERK

No. 86-2004

In the Supreme Court of the United States

OCTOBER TERM, 1987

ROBERT T. HOWITT, PETITIONER

v.

UNITED STATES DEPARTMENT OF COMMERCE

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

CHARLES FRIED
Solicitor General
RICHARD K. WILLARD
Assistant Attorney General
WILLIAM KANTER
JOHN FARGO
Attorneys
Department of Justice
Washington, D.C. 20530
(202) 633-2217

QUESTION PRESENTED

Whether the Court of Appeals for the Federal Circuit correctly held that it lacked ~~of~~ jurisdiction over an appeal from a decision of the Department of Commerce denying an application for attorney's fees under the Equal Access to Justice Act where the underlying proceedings in the Patent and Trademark Office were not subject to direct appeal to the Federal Circuit.

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35 U.S.C. (Supp. III) 145 ..... 2, 3, 4
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In the Supreme Court of the United States

OCTOBER TERM, 1987

No. 86-2004

ROBERT T. HOWITT, PETITIONER

v.

UNITED STATES DEPARTMENT OF COMMERCE

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-2a) is reported at 818 F.2d 877 (Table). The decision of the General Counsel of the Department of Commerce denying petitioner's request for attorney's fees (Pet. App. 3a-14a) is unreported. The decisions of the Commissioner of Patents denying petitioner's request for attorney's fees (Pet. App. 19a-28a) and denying reconsideration (Pet. App. 15a-18a) are unreported.

JURISDICTION

The judgment of the court of appeals (Pet. App. 75a) was entered on February 18, 1987. A petition for rehearing was denied on March 16, 1987 (Pet. App. 79a). The petition for a writ of certiorari was

filed as of June 13, 1987. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

This case arises out of petitioner's claim that he is entitled to an award of attorney's fees under the Equal Access to Justice Act (EAJA), 5 U.S.C. (Supp. III) 504, in connection with proceedings conducted by the Patent and Trademark Office (PTO) of the Department of Commerce.

1. In 1976, petitioner, who already held a patent on a type of snack table (No. 3,875,873) filed an application (Serial No. 728,129) for another snack table that was alleged to be an improved version of the first. The PTO examiner rejected petitioner's application on the ground that the claims for the second table were not sufficiently distinct from the claims of petitioner's prior patent (Pet. App. 65a). On July 16, 1980, the PTO Board of Appeals affirmed the examiner's determination on the ground that petitioner's application constituted "obviousness-type" double patenting (*id.* at 56a-59a).[1] Petitioner took no steps to challenge the Board's determination,[2] and

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[1] The doctrine of obviousness-type double patenting prevents a patentholder from enlarging the seventeen-year term of exclusivity under his initial patent by obtaining additional patents on obvious variations of the original invention. When a patent application is rejected on the ground of obviousness-type double patenting, the applicant may cure that defect by filing a terminal disclaimer, which provides that the later patent will expire on the same day as the earlier patent. See *In re Vogel*, 422 F.2d 438 (C.C.P.A. 1970).

[2] Petitioner did not seek reconsideration or clarification of the Board's decision; he did not appeal pursuant to 35 U.S.C. (Supp. III) 141; and he did not challenge the Board's determination in a civil action pursuant to 35 U.S.C. (Supp. III) 145.

the Board's action accordingly became final sixty days later on September 14, 1980 (see 37 C.F.R. 1.197(c)).

Instead, on the premise that the Board's determination permitted him to cure the deficiency in his application, petitioner filed a terminal disclaimer on November 19, 1980 (see note 1, *supra*), more than four months after the Board's decision had been entered and more than two months after the time within which to seek review of that decision had expired. The examiner rejected petitioner's terminal disclaimer, concluding that the disclaimer was untimely and that the application was therefore abandoned (Pet. App. 52a-53a).[3] Petitioner pursued administrative review of the examiner's decision rejecting his disclaimer and the Commissioner of Patents eventually withdrew the examiner's holding of abandonment (*id.* at 45a-46a).

2. Petitioner then requested an award of attorney's fees under the EAJA (see Pet. App. 22a). The Commissioner rejected that request because the PTO proceedings for which fees were sought were not adversary adjudications within the scope of the EAJA and because the positions taken by the PTO were substantially justified (*id.* at 19a-28a). On October 24, 1983, the Commissioner denied petitioner's request for reconsideration, noting additionally that the petition for attorney's fees had been filed out of time (*id.* at 15a-18a).

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[3] Under 37 C.F.R. 1.197(c), an application is abandoned if, within 60 days after the Board affirms the examiner's decision, the applicant fails to file an appeal or a civil action under 35 U.S.C. (Supp. III) 145. See also *Manual of Patent Examining Procedure* § 1214.06.

Petitioner took an appeal from the Commissioner's denial of attorney's fees to the General Counsel of the Department of Commerce (see 15 C.F.R. 18.10, 18.23). The General Counsel agreed with the Commissioner that the PTO proceedings for which petitioner sought an award of attorney's fees were not formal adjudications within the meaning of the Administrative Procedure Act (APA), 5 U.S.C. 554, and therefore were not within the scope of the EAJA, 5 U.S.C. (Supp. III) 504 (Pet. App. 3a-14a).

3. Petitioner sought review of the General Counsel's decision denying attorney's fees by filing an appeal in the Court of Appeals for the Federal Circuit. In an unpublished opinion (Pet. App. 1a-2a), the court dismissed the appeal for lack of jurisdiction. The court held that in the absence of jurisdiction to review the underlying agency determination on the merits it lacked jurisdiction to review the denial of attorney's fees.

ARGUMENT

The court of appeals' decision is correct and does not conflict with any decision of this Court or of any other court of appeals. Accordingly, further review is not warranted.

1. It is well settled that there are distinct forms of PTO proceedings with different avenues for appellate review: a decision by an examiner that rejects a patent application is subject to review by the Board of Appeals, and a decision of the Board of Appeals may be appealed to the Federal Circuit (28 U.S.C. (4 Supp. III) 1295(a)(4)(A); 35 U.S.C. (Supp. III) 141) or may be challenged in an action brought in district court (35 U.S.C. (Supp. III) 145); other decisions by an

examiner may be appealed by a petition to the Commissioner, and a decision by the Commissioner denying a petition is subject to review only by the commencement of a lawsuit in district court (*Digital Equipment Corp.* v. *Diamond*, 653 F.2d 701, 714 (1st Cir. 1981); *Rhone-Poulenc S.A.* v. *Dann*, 507 F.2d 261 (4th Cir. 1974), cert. denied, 422 U.S. 1009 (1975); *Winkler* v. *Ladd*, 21 F. Supp. 550 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1964); see also *Wyden* v. *Commissioner*, 807 F.2d 934, 940 & n.4 (Fed. Cir. 1986) (Markey, C.J., dissenting)). A decision by the Commissioner denying a petition may not be appealed directly to the Federal Circuit (*In re Makari*, 708 F.2d 709, 711 (Fed. Cir. 1983)).

These distinctions between forms of PTO proceedings are central to this case because the Equal Access to Justice Act states that jurisdiction to review an agency's denial of a claim for attorney's fees resides in the court having jurisdiction to review the merits of the underlying agency adjudication. 5 U.S.C. (Supp. III) 504(c)(2). The only administrative decision in this case that even arguably could have been the subject of a direct appeal to the court of appeals was the decision by the Board of Appeals affirming the examiner's rejection of petitioner's patent application.[4] But petitioner never appealed from the deci-

[4] As the Board's decision was issued in July 1980, it antedated the creation of the Federal Circuit. At that time, the appropriate forum for an appeal was the Court of Customs and Patent Appeals. Effective October 1, 1982, the Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, § 403, 96 Stat. 57, abolished the Court of Customs and Patent Appeals and established the Court of Appeals for the Federal Circuit as the sole forum for appeals from decisions of the PTO Board of Appeals and the PTO Board of Patent Interferences (now combined as the Board of Patent Appeals and Interferences).

sion of the Board of Appeals, nor did he seek attorneys' fees within 30 days after the time within which to appeal from the Board's decision had expired.[5] Rather, petitioner sought attorney's fees only after the Commissioner held, in a separate proceeding which could not have been the subject of an appeal to the Federal Circuit, that petitioner's patent application had not been abandoned. Since the merits of the Commissioner's determination could be reviewed only by an action in district court, the denial of attorney's fees was also subject to review only in district court.

2. Contrary to petitioner's contention (Pet. at 10-11, 12), the decision of the court of appeals does not conflict with prior decisions of the former Court of Customs and Patent Appeals (see note 4, *supra*). The cases upon which petitioner relies (*In re Haas*, 486 F.2d 1053 (C.C.P.A. 1973); *Margolis* v. *Banner*, 599 F.2d 435 (C.C.P.A. 1979)), stated that there might be a limited number of actions taken by patent examiners which, while not formally rejecting an application, constituted de facto rejections subject to appeal to the Board of Appeals and then to the

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[5] Indeed, the Board's decision became final and unappealable as of September 14, 1980—more than a year before the effective date of the EAJA. Pub. L. No. 96-481, § 208, 94 Stat. 2330. Because the EAJA applies only to actions that were pending on or after October 1, 1981, no attorney's fees could be recovered relating to the Board of Appeals decision even if it were considered an adversary adjudication. *Tyler Business Services, Inc.* v. *NLRB*, 695 F.2d 73, 77 (4th Cir. 1982). See also, *Nichols* v. *Pierce*, 740 F.2d 1249, 1255-1259 (D.C. Cir. 1984); *Berman* v. *Schweiker*, 713 F.2d 1290, 1301 (7th Cir. 1983).

former Court of Customs and Patent Appeals.[6] Yet, as the Federal Circuit held in *In re Makari*, 708 F.2d at 711, such decisions are the exception; the rule remains that the Federal Circuit "do[es] not have jurisdiction to review decisions of the Commissioner on petitions." In this case, which is consistent with *Makari* and distinguishable from *Haas* and *Margolis*, there was no reason to create an exception to permit petitioner to bypass the district court in seeking review of the denial of his EAJA claim.[7]

3. There is no merit to petitioner's contention (Pet. 14, 20) that the court of appeals erred in not transferring this action to a district court pursuant to 28 U.S.C. 1631. Petitioner made no request to have this case transferred until after the court of appeals had issued its decision and had denied rehearing. Not until he filed a petition to recall the mandate in the court of appeals did petitioner raise the issue of transfer under Section 1631. The court of appeals properly concluded that this case did not warrant the extraordinary step of recalling the mandate. See *In re Jones*, 542 F.2d 65, 68 (C.C.P.A. 1976); *In re Willis*, 537 F.2d 513, 515 (C.C.P.A. 1976); *Greater Boston Television Corp.* v. *FCC*, 463 F.2d 268, 278 (D.C. Cir. 1971), cert. denied, 406 U.S. 950 (1972).

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[6] *Haas* involved an appeal from the Board of Appeals, a matter that was clearly within the jurisdiction of the former Court of Customs and Patent Appeals. *Margolis* was an action for a writ of mandamus under the All Writs Act, 28 U.S.C. 1651(a).

[7] Because petitioner circumvented the district court, this case does not present the question whether an appeal from a district court lies to the Federal Circuit or to the regional court of appeals and petitioner's references to *Wyden* v. *Commissioner*, *supra*, are therefore inapposite (Pet. 7, 11).

In any event, Section 1631 is applicable only where the court finds that a transfer of jurisdiction is in the interest of justice. Where, as here, it is clear that the claim is meritless, the proper disposition is dismissal rather than transfer. *Zinger Construction Co.* v. *United States*, 753 F.2d 1053, 1055 (Fed. Cir. 1985). Section 504 of the EAJA applies only to agency "adversary adjudications" (under Section 554 of the APA) in which a hearing "on the record" is required by statute and in which the government is represented by counsel. *Railroad Commission* v. *United States*, 765 F.2d 221, 227 (D.C. Cir. 1985); *City of West Chicago* v. *United States Nuclear Regulatory Commission*, 701 F.2d 632, 642 (7th Cir. 1983). In general, the patent examination process is not adversarial since the government's interest in promoting progress in the useful arts is advanced by the granting of a patent that meets the statutory requirements. See H.R. Rep. 97-312, 97th Cong., 1st Sess. 20 (1981) ("the United States patent system * * * foster[s] technological growth and industrial innovation"). Moreover, Title 35 contains no requirement to hold a hearing on petitions to the Commissioner, much less a hearing "on the record." As the General Counsel concluded, this suggests that a petition to the Commissioner is an informal adjudication to which the APA and, consequently, the EAJA do not apply. See *Citizens To Preserve Overton Park* v. *Volpe*, 401 U.S. 402, 414-416 (1971). Finally, petitions to the Commissioner are processed without separate representation of the government. See *Cornella* v. *Schweiker*, 728 F.2d 978, 988-989 (8th Cir. 1984) (social security hearings are not considered adversary adjudications subject to the EAJA where the Secretary is not separately represented).

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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